

TRADEMARK AGENT EXAM 2019
PAPER A
Total Marks: 150

QUESTION 1 (5 marks)

Your client holds a registration in the U.S. for LAKESIDE VILLAGE for amusement arcades, and operates arcades in several resort towns in Michigan. They opened an arcade in a resort town in cottage country in Ontario about 5 years ago. As part of its enforcement strategy, your client has been monitoring the Canadian Trademarks Database for marks confusingly similar to LAKESIDE VILLAGE. Their monitoring service has recently advised them of a newly filed, not yet examined, Canadian application for LAKELAND VILLAGE covering “providing amusement arcade services”. Through one of your firm’s articles regarding the implementation of the changes to the *Trademarks Act*, your client learned of the Trademarks Office’s practice surrounding “Notification of Third Party Rights” and they have asked you to write to the Trademarks Office, notifying the office of their rights in LAKESIDE VILLAGE.

- a) Yes or No. Can your client take advantage of the “Notification of Third Party Rights” option? (1 mark) Explain your answer. (1 mark)
- b) Assuming that the LAKELAND VILLAGE mark is not yet in use and that your client does not wish to contact the applicant at this time regarding withdrawing its application for LAKELAND VILLAGE, what steps do you advise your client to take in connection with the application for LAKELAND VILLAGE? (3 marks)

QUESTION 2 (2 marks)

True or False. (1 mark) Pursuant to Paragraph 39(1)(b) of the *Trademarks Act*, a divisional application that is filed on or after the day on which the original application is advertised must contain goods or services that are within the scope of the original application on its filing date. Briefly explain your answer. (1 mark)

QUESTION 3 (16 marks)

Your client, Green Packaging Inc., a company that specializes in consumer packaging, has just launched a plastic bottle that degrades faster than the plastic bottles commonly used in the industry. In addition to its innovative degradable process, the bottle has a unique look as it is shaped like a tree trunk and the outside of the bottle feels exactly like maple bark. In addition, when the bottle is tilted at different angles, the waterfall shown in the centre of the bottle turns into a flock of birds.

- a) List the three most likely types of non-traditional trademarks that your client could consider applying for in connection with this new product (**3 marks**) and list all the specific requirements that must be included in an application for the registration of each of these non-traditional trademarks (**7 marks**). Cite the relevant provision of the *Trademarks Regulations* (**1 mark**), cite the relevant provisions of the *Trademarks Act* (**2 marks**) and cite the relevant authority for your answer (**1 mark**).
- b) If your client proceeds with an application for one or more of these non-traditional trademarks, what will the Trademarks Office almost certainly require in support of this/these application(s)? (**1 mark**) Cite the relevant provision of the *Trademarks Act*. (**1 mark**)

QUESTION 4 (2 marks)

True or False. (**1 mark**) It is possible to transfer an unregistered trademark in Canada. Cite the relevant provision of the *Trademarks Act*. (**1 mark**)

QUESTION 5 (2 marks)

A foreign consortium of producers of cured meats has asked you to protect a mark in Canada for ham. Your client says that the mark shows that the ham has qualities, characteristics or a reputation that are attributable to the place in which it is produced. Other than a regular trademark, list the two most likely types of protection potentially available for the consortium's mark under the *Trademarks Act*. (**2 marks**)

QUESTION 6 (2 marks)

True or False. (**1 mark**) It is possible to record a licence agreement in respect of Canadian trademark registrations and applications. Cite the relevant authority for your answer. (**1 mark**)

QUESTION 7 (6 marks)

XYZ Corp. assigned the rights in its trademark ZYLOFONE, along with its Canadian trademark registration for this mark, to 789 Corp. and has asked that you record the assignment against the registration for ZYLOFONE. Beyond the trademark in question and its application and registration number, list what you need to provide to the Canadian Intellectual Property Office in order to have the assignment recorded. (**3 marks**) Cite the relevant provisions of the *Trademarks Regulations* (**2 marks**) and cite the relevant authority for your answer. (**1 mark**)

QUESTION 8 (1 mark)

True or False. (1 mark) Consent from an official mark holder, pursuant to Subsection 9(2) of the *Trademarks Act*, is just one of the surrounding circumstances that will be considered by the Examiner in determining whether to withdraw an objection pursuant to Paragraph 12(1)(e) of the *Trademarks Act*.

QUESTION 9 (5 marks)

A “certification mark” is a sign or combination of signs that is used or proposed to be used for the purpose of distinguishing or so as to distinguish goods or services that are of a defined standard from those that are not of that defined standard with respect to what four (4) aspects of the goods or services? (4 marks) Cite the relevant provision of the *Trademarks Act*. (1 mark)

QUESTION 10 (2 marks)

Your client, a Canadian company, sends you a panicked e-mail on the Friday of the Family Day long weekend, after everyone has left for the day, advising that he has a priority filing deadline that falls the next day (on the Saturday), based on his U.S. application. Your Toronto office is closed for the Family Day Holiday on the Monday (February 17, 2020). True or False. (1 mark) You can file on Tuesday morning when your office reopens for business. In one sentence, explain why or why not. (1 mark)

QUESTION 11 (7 marks)

In 2018, Santa Clara Bakery Inc. filed an application for the trademark SANTA CLARA for “bakery products, namely cakes, pies and cookies”. The company’s CEO, Mr. Garcia, contacts you because he has received an Examiner’s report in which the Examiner requests confirmation that the goods originate from Santa Clara, since research shows that SANTA CLARA is a geographic name, namely a city in Cuba. The Examiner also objects to the registration of the mark based on Paragraph 12(1)(b) of the *Trademarks Act*, specifically, the Examiner considers the mark to be either clearly descriptive or deceptively misdescriptive of the place of origin of the goods.

Mr. Garcia has asked you to take over carriage of the application and prepare and file a proper response to the Examiner’s report.

Mr. Garcia further informs you that his bakery was named after his grandmother Clara, a woman who spent her entire life in a small village in Spain. She was known to bake “heavenly” desserts and villagers started to call her “Santa Clara” (Spanish for “Saint Clara”). He also confirms that the bakery products sold in association with the SANTA

CLARA mark are made using his grandmother's recipes and are manufactured in a factory in Laval, Quebec.


Your Internet search reveals that Santa Clara refers to 40 different cities around the world, including in Cuba, Portugal, Guatemala, Mexico and the United States.

Draft a response to the Examiner's report, addressing the issues raised by the Examiner. **(7 marks will be given, including 1 mark for the clarity of the response.)**

QUESTION 12 (8 marks)

Match the case name with the applicable legal principle. You have been provided with more legal principles than cases. Only one principle should be paired with one case. If you provide multiple legal principles, only the first legal principle given will be marked. **(1 mark for each correct answer for a maximum of 8 marks)**

Case Name	Principle
A. <i>ITV Technologies Inc. v. WIC Television Ltd.</i> , 2003 FC 1056 (CanLII), aff'd 2005 FCA 96 (CanLII) Trademark: ITV	1. In the normal course of things, the Registrar summarily examines the applications in chronological order, beginning with the one that has the earliest date of filing [or earliest priority date]. If there is no confusion with a mark that is pending when the application is filed... the application is accepted for advertisement by the Registrar and anyone who claims a previous use and confusion with his own mark may file a statement of opposition under section 38.
B. <i>Canadian Parking Equipment Ltd. v. Canada (Registrar of Trade Marks)</i> (1990), 34 C.P.R. (3d) 154 (FC) Trademark: AUTOMATIC PARKING DEVICES OF CANADA	2. [T]he degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis.... The other factors become significant only once the marks are found to be identical or very similar.
C. <i>Clarkson Gordon v. Registrar of Trade Marks</i> (1985), 5 C.P.R. (3d) 252 (FC)	3. If a requestor for an official mark is required to establish that it is a "public authority", it must also

Trademark: AUDITCOMPUTER	establish its “adoption and use”. The Registrar is not simply a rubber stamp in the process of securing an official mark by way of adoption and use.
D. Brûlerie Des Monts Inc. v. 3002462 Canada Inc. (1997), 75 C.P.R. (3d) 445 (FC) Trademark : LA BRÛLERIE	4. Trademarks law is not intended to prevent the competitive use of utilitarian features of products.
E. Kirkbi AG v. Ritvik Holdings Inc. , 2005 SCC 65 Trademark: “LEGO indicia”	5. While a statement of services may be more difficult to define in terms of the specific services as contrasted to a statement of goods, the <i>Trademarks Act</i> does require a measure of specificity in association with services, where it is reasonable to expect that a more specific statement of services in ordinary commercial terms can be provided by an applicant.
F. Attorney General of Canada v. Effigi Inc. (2005), 41 C.P.R. (4 th) 1 (FCA) Trademark: MAISON UNGAVA	6. Where the word is merely the name in French or English of the service in connection with which the trademark is used, it is not registrable.
G. Mövenpick-Holding AG v. Sobeys Capital Incorporated , 2010 TMOB 41 Trademark: 	7. [W]here an applicant points to a number of advertised and registered marks similar to the proposed mark, it is incumbent upon the registrar, in rejecting the application, to reconcile the inconsistencies to some extent. It is not enough to simply rely on the principle that each case must be decided on its own merits.
H. See You In – Canadian Athletes Fund Corporation v. Canadian Olympic Committee (2007), 57 C.P.R. (4 th) 287 (FC); aff’d (2008) 65 C.P.R. (4 th) 421 (FCA)	8. The inherent distinctiveness of a mark refers to its originality. A mark that is composed of a unique or invented name, such that it can only refer to one thing, will possess

Trademarks: SEE YOU IN ATHENS, SEE YOU IN TORINO, SEE YOU IN BEIJING, SEE YOU IN VANCOUVER	more inherent distinctiveness than a word that is commonly used in the trade.
	9. Evidence of what is commonly used in the trade to describe services (similar language used by others in the same industry) is important in assessing what constitutes “ordinary commercial terms”.
	10. The test for determining whether an entity is a public authority for the purpose of s. 9(1)(n)(iii) is the two-part test of government control and public benefit.
	11. A coined word made up of an awkward and cumbersome combination of two words that does not have a logical grammatical meaning may not be clearly descriptive.

QUESTION 13 (2 marks)

True or False. (1 mark) An applicant can pay a trademark registration fee directly, even if they have appointed an agent. Cite the relevant provision of the *Trademarks Regulations*. (1 mark)




QUESTION 14 (20 marks)

Your client, 5D REALITY INC., is interested in applying to register the trademark POWERFLAME for use in association with artificial fireplace logs. The mark has not yet been used in Canada. Prior to filing an application to register the POWERFLAME mark, your client has asked you to conduct a search of the Canadian Trademarks Register and to provide your opinion on the availability of the mark for registration and use.

For each of the marks identified by the search, and set out below:

- i. Indicate “yes” or “no” whether the mark is likely to pose an obstacle to registration of the POWERFLAME mark for the goods of interest. **(1 mark each)**
Note: “yes” means the mark is likely to pose an obstacle to registration, and “no” means the mark is not likely to pose an obstacle to registration.
- ii. Briefly (point form is acceptable) provide a valid explanation to support your opinion. **(1 mark each)** Please formulate your opinions from an examination/Trademarks Office perspective, not from an opposition perspective.

Note: No marks will be given for a “yes” or “no” answer unless a valid supporting explanation is given.

No.	TRADEMARK	STATUS and APP./REG. NO. and DATE	GOODS/SERVICES	OWNER
1.		Expunged (Section 45) Reg TMA 235,387 Reg 03-MAY- 1998	Wood heating fuel pellets; fireplace logs	PF Northern International Inc. Suite 3332, 1255 Burbridge Street Coquitlam BRITISH COLUMBIA V3K7B2
2.	POWERBLAZE	Advertised App 1645607 App 01-SEP- 2018	Fireplace logs; solid fire starters	Hot Stuff Equipment Inc. 332 Michelangelo Blvd Toronto ONTARIO L6T3Z8
3.		Formalized App 1904332 App 09-JUN- 2018	Fireplace logs	ULTRALOG INC. 382 ch. Bradley, Pontiac, Ontario Canada
4.		Registered Reg TMA 435876 Reg 27-OCT- 2003	Pellet burning stoves	DURAFLAME LTD. 1344 8th Ave W Vancouver BRITISH COLUMBIA V6H3V9

5.	POWERFLICKER	Advertised App 978273 APP 15-JAN-2015		Canadian Energy Board 3 Rideau Canal Lane Ottawa ONTARIO M6M4W9
6.	PWRFLME	Registered Reg TMA88754 Reg 12-NOV-2011	Mousepads; refrigerator magnets; jewellery, pendants, watches, souvenir coins; mugs, drinking glasses, cups, drink coasters; tea and hand towels, cloth flags; clothing, namely t-shirts, tank tops, muscle shirts, shorts, pants, overalls, jackets, vests, hats, caps, sweat shirts, sweat pants, underwear, pyjamas, scarves and gloves; smoking cessation and alternative smoking products, namely electronic cigarettes, smokeless electronic cigarettes, vaporizers, diffusers, smokeless cigarette vaporizer pipes; smoking cessation and alternative smoking accessories namely, atomizers, electronic cigarette refill cartridges, electronic cigarette lighters, electronic cigarette cases, electronic cigarette liquid, and electronic cigarette batteries and chargers; cartridges sold filled with propylene glycol for electronic cigarettes; flavorings in liquid form used to refill electronic	Liquid FLAME Inc 2 Fairview Street Burlington ONTARIO L7L6B7

			cigarette cartridges; bottles for electronic cigarette liquid and flavors; cigarette cases; extracts and additives for use as food, beverage and smoking cessation and alternative smoking products flavouring.	
7.	WONDERFLAME	Registered Reg TMA548723 Reg 10-DEC-2001	Consumer electronic products, namely, lighting fixtures, LED (light emitting diode) lighting fixtures, LED candles, flameless candles, scented electric candles, indoor electric candles, outdoor electric candles, electric pillar candles, electric votive candles, electric taper candles	Shenzhen Liown Electronics Co., Ltd. No. 7 Gongye 3rd Road, Shekou, Nanshan District Shenzhen, Guangdong 518067 CHINA
8.	WONDERGLOW	Advertised App 1893345 App 09-JUN-2017	Fireplace heating inserts	Innovative Glow Products LLC 1508 Elm Hill Pike Suite 108 Nashville, Tennessee 37210 UNITED STATES OF AMERICA
9.	POWERBURN	Registered Reg TMA887443 Reg 09-SEP-2014	Solid fire starters, matches, log carriers, artificial fireplace logs	5D REALITY INC. 1 Spring Street Vancouver BC V5K1B1
10.	POWERFLAME	Granted Reg PBRA3982 Date Granted 28-AUG-1987	Geranium (Geranium Cinereum)	Regan Reginald Carter UNITED KINGDOM

QUESTION 15 (12 marks)

Mr. Paul Johnson owns an ice cream parlour in Toronto by the name of SAYONARA. He is now thinking about retiring and selling his company, Sayonara Ice Cream Inc. He has found a potential buyer for his business and believes that he could sell it for a higher price if he owned a registered trademark. On January 7, 2019, Mr. Johnson filed the trademark SAYONARA himself, but the application has not yet been assigned to an examiner. Mr. Johnson now contacts you to ask if it would be possible to speed up the registration process of his mark. According to the Trademarks Database, the particulars of Mr. Johnson's application are as follows:

Application No.: 1,222,333
Filed: 2019-01-07

Trademark: SAYONARA
Type: word-mark
Category: trademark

Applicant:
Sayonara Ice Cream Inc.
123 Frost Street
Toronto

Goods: Ice cream, ice cream cakes, t-shirts, aprons and other promotional items.

Services: Ice cream parlours.

Claims: Used in Canada since 1983

- a) In order to avoid unnecessary delays during examination, Mr. Johnson asks you to review the application for SAYONARA to determine whether there are any amendments that can be made now to help avoid the issuance of an Examiner's report. List four items that will need to be addressed in order to avoid an Examiner's report (**4 marks**) and cite the relevant provisions of the *Trademarks Act* or *Trademarks Regulations* for each item (**4 marks**).
- b) Assuming you proceed with filing these amendments immediately, when will they be assessed by the Trademarks Office? (**1 mark**) Cite the relevant authority for your answer. (**1 mark**)
- c) Yes or No. (**1 mark**) Is it possible to expedite examination of the trademark application? Cite the relevant authority for your answer. (**1 mark**)

QUESTION 16 (8 marks)

Your client, Suzie Bellamy, is the author of a series of children's books named HIDE AND SEEK STREET. The first book in this series was published in 2015 and was an instant success with preschoolers throughout Canada. In 2016, your client launched several promotional items bearing the HIDE AND SEEK STREET trademark and decided to file a trademark application for the mark with the Canadian Trademarks Office. The mark is now registered as follows:

Application No.: 1,789,789
Filed: 2016-07-03

Registration No.: 991,991
Registered: 2018-03-01

Trademark: HIDE AND SEEK STREET
Type: word-mark
Category: trademark

Applicant:
Suzie Bellamy
958 Pineview
Vancouver, BC
V5Z 1M9

Goods:
(1) Children's books.
(2) T-shirts, school bags, posters and colouring books.

Claims: Used in Canada since at least as early as December 2015 on goods (1).
Used in Canada since at least as early as June 2016 on goods (2).

In September 2018, Ms. Bellamy started selling her books and merchandise in several English-speaking countries. She has now launched an educational software application for tablets and smartphones and this application has quickly become one of the most downloaded educational applications in Canada, the United States, the United Kingdom, Ireland and Australia.

Ms. Bellamy contacts you because she would like to protect her trademark internationally for her books, merchandise and educational application, but she has a limited budget.

Taking into account your client's budgetary limitations, what would be the best strategy to adopt to ensure that Ms. Bellamy's trademark is fully protected in Canada and in the countries where her products are currently sold? Briefly explain the steps you would

need to take and list the applications to file and the particulars of each application. (8 marks)

QUESTION 17 (5 marks)

True or False. Putting aside any considerations of state of the Register or marketplace, the following trademarks would be considered to have no inherent distinctiveness:

- a) The representation of a cat-shaped balloon with a party hat for “cat toys”. (1 mark)
- b) WET for “bottled water”. (1 mark)
- c) LUCIE’S CARROT CAKE for “carrot cake”. (1 mark)
- d) 1-800-MUFFINS for “home delivery of fresh muffins”. (1 mark)
- e) MILLER DAVIS for “insurance services”. (1 mark)

QUESTION 18 (4 marks)

Your client asked you to file a trademark application for ALIENINVASION for clothing. About 13 months later, you received an official letter requesting that the applicant provide further particulars of the term “clothing”. The client instructed you to respond by amending the goods to read “casual clothing” and you filed the response 4 months ago. Your client has now started using its mark on t-shirts and realizes that they prefer ALIEN INVASION as two words instead of one. They have asked you if it is possible to amend the application to reflect ALIEN INVASION as two words. Yes or No. (1 mark) Is it likely that the Trademarks Office will permit this amendment? Provide a one-sentence explanation for your answer. (2 marks) Cite the relevant provision of the *Trademarks Regulations*. (1 mark)

QUESTION 19 (3 marks)

A trademark application was filed before June 17, 2019 for a word mark, without any statement that the mark consists of standard characters. Assuming no objections are raised, in one sentence explain how the application will be treated by the Examiner. (2 marks) Cite the relevant authority for your answer. (1 mark).

QUESTION 20 (1 mark)

On June 20, 2019, you filed an International trademark application based on a Canadian trademark registered on March 26, 2015. The International trademark was registered on September 8, 2019. Until what date does the International trademark depend on the basic Canadian registration? (1 mark)

QUESTION 21 (5 marks)

You filed an application on behalf of your client, claiming priority to its EU trademark application. The Canadian application has been advertised, and you forwarded a copy of the advertisement to your client. In speaking with the client, you learn that the EU trademark application is actually in the name of a company related to the Canadian applicant, but not a predecessor-in-title to the Canadian applicant.

- a) True or False. (1 mark) A Canadian trademark application cannot claim priority to an EU trademark application. Cite the relevant provision of the *Trademarks Act*. (1 mark)
- b) True or False. (1 mark) You can withdraw the priority claim. Cite the relevant provision of the *Trademarks Act* (1 mark) and of the *Trademarks Regulations*. (1 mark)

QUESTION 22 (4 marks)

A U.S. certifying body that holds registrations for its certification mark in the U.S. and certifies the goods under the mark in the U.S. would like to file for its certification mark in Canada, but the mark is not yet in use in Canada. Yes or No. (1 mark) Can the U.S. certifying body obtain protection for its mark in Canada as a certification mark if the mark is not yet in use in Canada? What are the requirements for application for registration of a certification mark under the *Trademarks Act* specific to certification marks and not to other types of marks. (2 marks) Cite the relevant provision of the *Trademarks Act*. (1 mark)

QUESTION 23 (3 marks)

An application is filed online in association with "marble statues" in Class 19 and "statues made of common metal" in Class 6 together with a filing fee of \$330 and obtains a filing date. The application is subsequently revised to remove "statues made of common metal" from the application. Yes or No. (1 mark) Are any further fees required? Provide a brief explanation. (2 marks)

QUESTION 24 (3 marks)

Your client is a U.S. trademark attorney, on whose instruction you have filed a number of Canadian trademark applications, on behalf of one of their clients (the applicant). You receive an e-mail from a U.S. attorney at a different firm, stating that they are taking over carriage of the applicant's trademark portfolio, and instructing you to communicate only with them going forward in connection with the applicant's Canadian trademark

matters. Neither your client, nor the applicant, is copied on this e-mail. Briefly explain how you should handle this situation and why. **(3 marks)**

QUESTION 25 (19 marks)

You filed an application for registration of the mark CANADA FRESH on behalf of your Canadian client, CF Limited, on June 18, 2019, for:

Class 16: “books and periodical publications”;

Class 25: “casual clothing and casual footwear”;

Class 30: “meat and cheese; bread, pasta and pastry”;

Class 31: “unprocessed raw fruits and vegetables”; and

Class 32: “fruit juice”.

Your client informs you that the trademark has been used in Canada in association with these goods since 2012, and that all of its goods are manufactured in Canada.

The application has been examined and the Examiner has issued the following Office Action:

26 Oct 2019

Your File

123-456789

Our File

1970200

Your Firm

Somewhere in Canada

Re: Trademark: CANADA FRESH

Applicant: CF Limited

This examiner’s report concerns the above-identified application. To avoid abandonment proceedings, a proper response must be received by this office by April 26, 2020. All correspondence respecting this application must indicate the file number.

The applicant is requested to confirm that the associated goods originate from CANADA, as research shows that this word is primarily a geographic name. Goods originate from a geographic location if they are manufactured, produced, grown, assembled, or designed there.

If the goods do not originate from CANADA, then the trademark as a whole deceptively misdescribes the place of origin of the goods. The average Canadian consumer or dealer would be misled into the belief that the associated goods

originate from CANADA, and therefore the trademark is unregistrable pursuant to paragraph 12(1)(b) of the *Trademarks Act*.

If, however, the goods originate from CANADA, then the trademark as a whole clearly describes the character and place of origin of the following associated goods, namely, meat, cheese, bread, pasta, pastry, unprocessed raw fruit and vegetables and fruit juice, and is therefore unregistrable pursuant to paragraph 12(1)(b) of the *Trademarks Act*. Specifically, the trademark clearly describes that the applicant's goods are fresh meat, cheese, bread, pastry, fruit, vegetables and fruit juice that originate from Canada.

Alternatively, if these goods are not fresh, then the trademark is considered to be deceptively misdescriptive.

Therefore, in view of the provisions of paragraph 12(1)(b) of the *Trademarks Act*, the trademark does not appear registrable.

Furthermore, pursuant to paragraph 37(1)(d) of the *Trademarks Act*, it appears that the trademark is not distinctive.

The Registrar's preliminary view is that the trademark is not inherently distinctive for the aforementioned goods, namely, meat, cheese, bread, pasta, pastry, unprocessed raw fruit and vegetables and fruit juice, as trademarks which do not appear registrable pursuant to paragraph 12(1)(b) of the *Trademarks Act* are considered not inherently distinctive.

In particular, the subject trademark does not distinguish the goods of the applicant from those of another person or business in that the trademark clearly describes the character and place of origin of the applicant's goods, namely that the goods are fresh and originate from Canada. As such, the consumer would not be able to distinguish the source of the applicant's goods from those of a competitor since the applied-for trademark is merely a generic description of a particular characteristic and place of origin of the goods.

Therefore, pursuant to paragraph 32(1)(b) of the *Act* the applicant is required to furnish the Registrar with evidence establishing that the trademark was distinctive at the filing date of the application for its registration. Please note that pursuant to subsection 32(2) of the *Act*, the Registrar shall, having regard to the evidence adduced, restrict the registration to the goods in association with which, and to the defined territorial area in Canada in which, the trademark is shown to be distinctive.

Any comments you may wish to submit will receive consideration.

If the applicant has any specific questions in respect of this office action, please contact the assigned examiner.

Yours truly,

Anita Bev Orage
Examination Section

- a) Assuming your client is interested in obtaining a registration for its CANADA FRESH mark as soon as possible, what steps do you recommend that your client take. **(5 marks)**
- b) In preparing the affidavit evidence pursuant to Subsection 32(1) of the *Trademarks Act*, assuming that you will be filing a company affidavit sworn/affirmed on behalf of CF Limited, list, in point form, the most important information and/or documents to be included in the affidavit. **(10 marks)**
- c) In view of the objection pursuant to Paragraph 12(1)(b) of the *Trademarks Act*, other than Paragraph 32(1)(b), cite the other two provisions of the *Trademarks Act* relevant to the distinctiveness claim. **(2 marks)**
- d) You were not able to collect all of the necessary evidence within the initial six months, and so requested the permissible six-month extension of time to respond to the outstanding Office Action. The extended deadline is now looming, and you still do not have all the necessary evidence together. True or False. **(1 mark)** Your client can obtain a further extension of time, based on exceptional circumstances, to finish compiling its evidence. Cite the relevant authority for your answer. **(1 mark)**

QUESTION 26 (3 marks)

Your firm, IP Fuel Trademark Services, has been asked to respond to an Office Action in connection with an application by Awesome Ski Clothing Ltd. to register the trademark STORM VALLEY for ski clothing. The Office Action cites the registered trademark for STORM CANYON, below. What do you advise Awesome Ski Clothing Ltd. **(2 marks)** Cite the relevant authority. **(1 mark)**

STORM CANYON — 16245438

Application number
16245438

Registration number
TMA937032

Type(s)
Word

Index headings
STORM CANYON

Goods

(1) Clothing, namely, men's, women's, and children's T-shirts, shirts, tops, sweatshirts, sweatpants, pants, side zip pants, shorts, vests, parkas, anoraks, coats, jackets, wind-resistant jackets, jacket hoods, pullovers, sweaters; outerwear, namely, shells, ski wear, ski vests, ski jackets, snowboard wear, snow pants, rain wear, rain jackets, rain pants; headgear, namely, hats, beanies.

Category

Trademark

CIPO status

REGISTERED

Filed

2013-04-23

Registered

2016-05-10

Registration Expiry Date

2031-05-10

Current owner

SKI Trading Company, Inc.
624 SKI Blvd. the Skihill,
CANADA

Agent

IP FUEL TRADEMARK
SERVICES
Ottawa City P.O. BOX 0,
CANADA

Registrant

Welch Apparel Group, Inc.
624 Spiral Blvd. Hastings, MN
55033 UNITED STATES OF
AMERICA

Applicant**Classification data****Disclaimer**

The classification data is provided for information and searching purposes only. CIPO does not warrant the accuracy of the classes assigned to the trademark. This data has no legal value of any kind.

25 - Clothing, footwear, headgear

Action History

Action	Action date	Due date	Comments
Filed	2013-04-23		
Created	2013-04-24		
Formalized	2013-04-25		
Search Recorded	2014-01-14		
Approval Notice Sent	2014-01-14	2014-02-11	
Approved	2014-03-06		APPROVED BY PROGRAM EX200M1
Advertised	2014-03-12		Vol.61 Issue 3098
Allowed	2014-06-27		
Allowance Notice Sent	2014-06-27	2016-04-23	
Registered	2016-05-10	2031-05-10	

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PAPER A
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QUESTION 1 (5 marks)

Your client holds a registration in the U.S. for LAKESIDE VILLAGE for amusement arcades, and operates arcades in several resort towns in Michigan. They opened an arcade in a resort town in cottage country in Ontario about 5 years ago. As part of its enforcement strategy, your client has been monitoring the Canadian Trademarks Database for marks confusingly similar to LAKESIDE VILLAGE. Their monitoring service has recently advised them of a newly filed, not yet examined, Canadian application for LAKELAND VILLAGE covering “providing amusement arcade services”. Through one of your firm’s articles regarding the implementation of the changes to the *Trademarks Act*, your client learned of the Trademarks Office’s practice surrounding “Notification of Third Party Rights” and they have asked you to write to the Trademarks Office, notifying the office of their rights in LAKESIDE VILLAGE.

- a) Yes or No. Can your client take advantage of the “Notification of Third Party Rights” option? (1 mark) Explain your answer. (1 mark)

Answer:

- No. (1 mark)
- Arguments or evidence of prior use will not be accepted **OR** client does not have a registered Canadian trademark or pending Canadian application. (1 mark)

- b) Assuming that the LAKELAND VILLAGE mark is not yet in use and that your client does not wish to contact the applicant at this time regarding withdrawing its application for LAKELAND VILLAGE, what steps do you advise your client to take in connection with the application for LAKELAND VILLAGE? (3 marks)

Answer:

- immediately file an application for the LAKESIDE VILLAGE mark. (1 mark)
- continue to monitor the application for the LAKELAND VILLAGE mark. (1 mark)
- oppose the LAKELAND VILLAGE mark once it is advertised. (1 mark)

QUESTION 2 (2 marks)

True or False. (1 mark) Pursuant to Paragraph 39(1)(b) of the *Trademarks Act*, a divisional application that is filed on or after the day on which the original application is advertised must contain goods or services that are within the scope of the original application on its filing date. Briefly explain your answer. (1 mark)

Answer:

- False. (1 mark)
- Paragraph 39(1)(b) of the *Trademarks Act* provides that the goods or services must be within the scope of the original application on the day on which the divisional application is filed, if the divisional application is filed on or after the day on which the original application is advertised. (1 mark)

QUESTION 3 (16 marks)

Your client, Green Packaging Inc., a company that specializes in consumer packaging, has just launched a plastic bottle that degrades faster than the plastic bottles commonly used in the industry. In addition to its innovative degradable process, the bottle has a unique look as it is shaped like a tree trunk and the outside of the bottle feels exactly like maple bark. In addition, when the bottle is tilted at different angles, the waterfall shown in the centre of the bottle turns into a flock of birds.

- a) List the three most likely types of non-traditional trademarks that your client could consider applying for in connection with this new product (3 marks) and list all the specific requirements that must be included in an application for the registration of each of these non-traditional trademarks (7 marks). Cite the relevant provision of the *Trademarks Regulations* (1 mark), cite the relevant provisions of the *Trademarks Act* (2 marks) and cite the relevant authority for your answer (1 marks).

Answer:

- Three-dimensional shape OR mode of packaging goods for the bottle shaped like a tree trunk. (1 mark) The application must include a statement to the effect that the mark consists of a three-dimensional shape **OR** a mode of packaging goods (1 mark) and a visual representation of the bottle. (1 mark)
- Texture for the maple bark texture of the bottle. (1 mark) The application must include a statement to the effect that the mark consists of a texture (1 mark) and a clear and concise description of the tactile qualities of the trademark. (1 mark)
- Hologram for the depiction of a waterfall changing into a flock of birds. (1 mark) The application must include a statement to the effect that the mark consists of a hologram (1 mark), a visual representation in the form of one or more still images (1 mark) and a clear and concise description of the visual effect when the hologram is viewed from different angles. (1 mark)
- Subsection 31(e) of the *Trademarks Regulations*. (1 mark)
- Paragraphs 30(2)(c) (1 mark) and 30(2)(d) (1 mark) of the *Trademarks Act*.
- Practice Notice dated June 17, 2019, "Non-traditional Trademarks" **OR** Trademarks Examination Manual Section 2.4.10. (1 mark) [**Note: Date and title of Practice Notice and/or particular section of the Examination Manual not required to receive the mark.**]

- b) If your client proceeds with an application for one or more of these non-traditional trademarks, what will the Trademarks Office almost certainly require in support of this/these application(s)? **(1 mark)** Cite the relevant provision of the *Trademarks Act*. **(1 mark)**

Answer:

- That the applicant file evidence establishing that the trademark is distinctive at the application filing date **OR** that the trademark has acquired secondary meaning at the application filing date. **(1 mark)**
- Subsection 32(1) of the *Trademarks Act*. **(1 mark)**

QUESTION 4 (2 marks)

True or False. **(1 mark)** It is possible to transfer an unregistered trademark in Canada. Cite the relevant provision of the *Trademarks Act*. **(1 mark)**

Answer:

- True. **(1 mark)**
- Subsection 48(1) of the *Trademarks Act*. **(1 mark)**

QUESTION 5 (2 marks)

A foreign consortium of producers of cured meats has asked you to protect a mark in Canada for ham. Your client says that the mark shows that the ham has qualities, characteristics or a reputation that are attributable to the place in which it is produced. Other than a regular trademark, list the two most likely types of protection potentially available for the consortium's mark under the *Trademarks Act*. **(2 marks)**

Answer:

- Certification mark. **(1 mark)**
- Geographical indication. **(1 mark)**

QUESTION 6 (2 marks)

True or False. **(1 mark)** It is possible to record a licence agreement in respect of Canadian trademark registrations and applications. Cite the relevant authority for your answer. **(1 mark)**

Answer:

- True. **(1 mark)**

- Practice Notice dated June 17, 2019, "License agreements" **OR** paragraph 26(2)(c) of the *Trademarks Act*. (1 mark)

[Note: Date and title of Practice Notice not required to receive the mark.]

QUESTION 7 (6 marks)

XYZ Corp. assigned the rights in its trademark ZYLOFONE, along with its Canadian trademark registration for this mark, to 789 Corp. and has asked that you record the assignment against the registration for ZYLOFONE. Beyond the trademark in question and its application and registration number, list what you need to provide to the Canadian Intellectual Property Office in order to have the assignment recorded. (3 marks) Cite the relevant provisions of the *Trademarks Regulations* (2 marks) and cite the relevant authority for your answer. (1 mark)

Answer:

- Prescribed fee **OR** \$100 dollars. (1 mark)
- Transferee's name. (1 mark)
- Transferee's postal address. (1 mark)
- Sections 64 (1 mark) and 65 (1 mark) of the *Trademarks Regulations*.
- Practice Notice dated June 17, 2019, "Transfers and Change of Name". (1 mark)

[Note: Date and title of Practice Notice not required to receive the mark.]

QUESTION 8 (1 mark)

True or False. (1 mark) Consent from an official mark holder, pursuant to Subsection 9(2) of the *Trademarks Act*, is just one of the surrounding circumstances that will be considered by the Examiner in determining whether to withdraw an objection pursuant to Paragraph 12(1)(e) of the *Trademarks Act*.

Answer:

- False. (1 mark)

QUESTION 9 (5 marks)

A "certification mark" is a sign or combination of signs that is used or proposed to be used for the purpose of distinguishing or so as to distinguish goods or services that are of a defined standard from those that are not of that defined standard with respect to what four (4) aspects of the goods or services? (4 marks) Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

- **character or quality** of the goods or services. (1 mark)
- **working conditions** under which the goods are produced or the services performed. (1 mark)
- **class of persons** by whom the goods are produced or the services performed. (1 mark)
- **area within which** the goods are produced or the services performed. (1 mark)
- Section 2 of the *Trademarks Act*. (1 mark)

QUESTION 10 (2 marks)

Your client, a Canadian company, sends you a panicked e-mail on the Friday of the Family Day long weekend, after everyone has left for the day, advising that he has a priority filing deadline that falls the next day (on the Saturday), based on his U.S. application. Your Toronto office is closed for the Family Day Holiday on the Monday (February 17, 2020). True or False. (1 mark) You can file on Tuesday morning when your office reopens for business. In one sentence, explain why or why not. (1 mark)

Answer:

- False. (1 mark)
- Family Day is not a national statutory holiday **OR** the Trademarks Office is not closed for business on the Family Day Holiday **OR** the Trademarks Office is open for business on Family Day **OR** Family Day is not a *dies non*. (1 mark)

QUESTION 11 (7 marks)

In 2018, Santa Clara Bakery Inc. filed an application for the trademark SANTA CLARA for “bakery products, namely cakes, pies and cookies”. The company’s CEO, Mr. Garcia, contacts you because he has received an Examiner’s report in which the Examiner requests confirmation that the goods originate from Santa Clara, since research shows that SANTA CLARA is a geographic name, namely a city in Cuba. The Examiner also objects to the registration of the mark based on Paragraph 12(1)(b) of the *Trademarks Act*, specifically, the Examiner considers the mark to be either clearly descriptive or deceptively misdescriptive of the place of origin of the goods.

Mr. Garcia has asked you to take over carriage of the application and prepare and file a proper response to the Examiner’s report.

Mr. Garcia further informs you that his bakery was named after his grandmother Clara, a woman who spent her entire life in a small village in Spain. She was known to bake “heavenly” desserts and villagers started to call her “Santa Clara” (Spanish for “Saint Clara”). He also confirms that the bakery products sold in association with the SANTA CLARA mark are made using his grandmother’s recipes and are manufactured in a factory in Laval, Quebec.

Your Internet search reveals that Santa Clara refers to 40 different cities around the world, including in Cuba, Portugal, Guatemala, Mexico and the United States.

Draft a response to the Examiner's report, addressing the issues raised by the Examiner. **(7 marks will be given, including 1 mark for the clarity of the response.)**

Answer:


- Appoint yourself as agent for this matter. **(1 mark)**
- Inform the Examiner that the goods do not originate from Santa Clara. **(1 mark)**
- Since the goods do not originate from Santa Clara, the mark is not clearly descriptive of the place of origin of the goods. **(1 mark)**
- The trademark is not deceptively misdescriptive **(1 mark)** since it has other meanings **OR** refers to the nickname given to the CEO's grandmother as well as 40 different cities worldwide **(1 mark)** and the average Canadian consumer would not recognize the mark as a geographic name as a matter of first impression **OR** Santa Clara is not known for bakery products. **(1 mark)**
- Clarity. **(1 mark)**

QUESTION 12 (8 marks)

Match the case name with the applicable legal principle. You have been provided with more legal principles than cases. Only one principle should be paired with one case. If you provide multiple legal principles, only the first legal principle given will be marked. **(1 mark for each correct answer for a maximum of 8 marks)**

Case Name	Principle
A. <i>ITV Technologies Inc. v. WIC Television Ltd.</i> , 2003 FC 1056 (CanLII), aff'd 2005 FCA 96 (CanLII) Trademark: ITV	1. In the normal course of things, the Registrar summarily examines the applications in chronological order, beginning with the one that has the earliest date of filing [or earliest priority date]. If there is no confusion with a mark that is pending when the application is filed... the application is accepted for advertisement by the Registrar and anyone who claims a previous use and confusion with his own mark may file a statement of opposition under section 38.

<p>B. Canadian Parking Equipment Ltd. v. Canada (Registrar of Trade Marks) (1990), 34 C.P.R. (3d) 154 (FC)</p> <p>Trademark: AUTOMATIC PARKING DEVICES OF CANADA</p>	<p>2. [T]he degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis.... The other factors become significant only once the marks are found to be identical or very similar.</p>
<p>C. Clarkson Gordon v. Registrar of Trade Marks (1985), 5 C.P.R. (3d) 252 (FC)</p> <p>Trademark: AUDITCOMPUTER</p>	<p>3. If a requestor for an official mark is required to establish that it is a “public authority”, it must also establish its “adoption and use”. The Registrar is not simply a rubber stamp in the process of securing an official mark by way of adoption and use.</p>
<p>D. Brûlerie Des Monts Inc. v. 3002462 Canada Inc. (1997), 75 C.P.R. (3d) 445 (FC)</p> <p>Trademark : LA BRÛLERIE</p>	<p>4. Trademarks law is not intended to prevent the competitive use of utilitarian features of products.</p>
<p>E. Kirkbi AG v. Ritvik Holdings Inc., 2005 SCC 65</p> <p>Trademark: “LEGO indicia”</p>	<p>5. While a statement of services may be more difficult to define in terms of the specific services as contrasted to a statement of goods, the <i>Trademarks Act</i> does require a measure of specificity in association with services, where it is reasonable to expect that a more specific statement of services in ordinary commercial terms can be provided by an applicant.</p>
<p>F. Attorney General of Canada v. Effigi Inc. (2005), 41 C.P.R. (4th) 1 (FCA)</p> <p>Trademark: MAISON UNGAVA</p>	<p>6. Where the word is merely the name in French or English of the service in connection with which the trademark is used, it is not registrable.</p>
<p>G. Mövenpick-Holding AG v. Sobeys Capital Incorporated, 2010 TMOB 41</p>	<p>7. [W]here an applicant points to a number of advertised and registered marks similar to the</p>

<p>Trademark:</p> 	<p>proposed mark, it is incumbent upon the registrar, in rejecting the application, to reconcile the inconsistencies to some extent. It is not enough to simply rely on the principle that each case must be decided on its own merits.</p>
<p>H. <i>See You In – Canadian Athletes Fund Corporation v. Canadian Olympic Committee</i> (2007), 57 C.P.R. (4th) 287 (FC); aff'd (2008) 65 C.P.R. (4th) 421 (FCA)</p> <p>Trademarks: SEE YOU IN ATHENS, SEE YOU IN TORINO, SEE YOU IN BEIJING, SEE YOU IN VANCOUVER</p>	<p>8. The inherent distinctiveness of a mark refers to its originality. A mark that is composed of a unique or invented name, such that it can only refer to one thing, will possess more inherent distinctiveness than a word that is commonly used in the trade.</p>
	<p>9. Evidence of what is commonly used in the trade to describe services (similar language used by others in the same industry) is important in assessing what constitutes “ordinary commercial terms”.</p>
	<p>10. The test for determining whether an entity is a public authority for the purpose of s. 9(1)(n)(iii) is the two-part test of government control and public benefit.</p>
	<p>11. A coined word made up of an awkward and cumbersome combination of two words that does not have a logical grammatical meaning may not be clearly descriptive.</p>

Answer:

- A-8 (1 mark)
- B-7 (1 mark)
- C-11 (1 mark)
- D-6 (1 mark)
- E-4 (1 mark)

F-1 (1 mark)
G-9 (1 mark)
H-3 (1 mark)

QUESTION 13 (2 marks)

True or False. (1 mark) An applicant can pay a trademark registration fee directly, even if they have appointed an agent. Cite the relevant provision of the *Trademarks Regulations*. (1 mark)

Answer:

- True. (1 mark)
- Paragraph 25(3)(b) of the *Trademarks Regulations*. (1 mark)


QUESTION 14 (20 marks)


Your client, 5D REALITY INC., is interested in applying to register the trademark POWERFLAME for use in association with artificial fireplace logs. The mark has not yet been used in Canada. Prior to filing an application to register the POWERFLAME mark, your client has asked you to conduct a search of the Canadian Trademarks Register and to provide your opinion on the availability of the mark for registration and use.

For each of the marks identified by the search, and set out below:

- i. Indicate “yes” or “no” whether the mark is likely to pose an obstacle to registration of the POWERFLAME mark for the goods of interest. (1 mark each) **Note: “yes” means the mark is likely to pose an obstacle to registration, and “no” means the mark is not likely to pose an obstacle to registration.**
- ii. Briefly (point form is acceptable) provide a valid explanation to support your opinion. (1 mark each) Please formulate your opinions from an examination/Trademarks Office perspective, not from an opposition perspective.

Note: No marks will be given for a “yes” or “no” answer unless a valid supporting explanation is given.


No.	TRADEMARK	STATUS and APP./REG. NO. and DATE	GOODS/SERVICES	OWNER
1.		Expunged (Section 45) Reg TMA 235,387	Wood heating fuel pellets; fireplace logs	PF Northern International Inc. Suite 3332, 1255 Burbridge Street



		Reg 03-MAY-1998		Coquitlam BRITISH COLUMBIA V3K7B2
2.	POWERBLAZE	Advertised App 1645607 App 01-SEP-2018	Fireplace logs; solid fire starters	Hot Stuff Equipment Inc. 332 Michelangelo Blvd Toronto ONTARIO L6T3Z8
3.		Formalized App 1904332 App 09-JUN-2018	Fireplace logs	ULTRALOG INC. 382 ch. Bradley, Pontiac, Ontario Canada
4.	duraflame	Registered Reg TMA 435876 Reg 27-OCT-2003	Pellet burning stoves	DURAFLAME LTD. 1344 8th Ave W Vancouver BRITISH COLUMBIA V6H3V9
5.	POWERFLICKER	Advertised App 978273 APP 15-JAN-2015		Canadian Energy Board 3 Rideau Canal Lane Ottawa ONTARIO M6M4W9
6.	PWRFLME	Registered Reg TMA88754 Reg 12-NOV-2011	Mousepads; refrigerator magnets; jewellery, pendants, watches, souvenir coins; mugs, drinking glasses, cups, drink coasters; tea and hand towels, cloth flags; clothing, namely t-shirts, tank tops, muscle shirts, shorts, pants, overalls,	Liquid FLAME Inc 2 Fairview Street Burlington ONTARIO L7L6B7

			jackets, vests, hats, caps, sweat shirts, sweat pants, underwear, pyjamas, scarves and gloves; smoking cessation and alternative smoking products, namely electronic cigarettes, smokeless electronic cigarettes, vaporizers, diffusers, smokeless cigarette vaporizer pipes; smoking cessation and alternative smoking accessories namely, atomizers, electronic cigarette refill cartridges, electronic cigarette lighters, electronic cigarette cases, electronic cigarette liquid, and electronic cigarette batteries and chargers; cartridges sold filled with propylene glycol for electronic cigarettes; flavorings in liquid form used to refill electronic cigarette cartridges; bottles for electronic cigarette liquid and flavors; cigarette cases; extracts and additives for use as food, beverage and smoking cessation and alternative smoking products flavouring.	
7.	WONDERFLAME	Registered Reg TMA548723 Reg 10-DEC-2001	Consumer electronic products, namely, lighting fixtures, LED (light emitting diode) lighting fixtures, LED candles, flameless candles, scented electric	Shenzhen Liown Electronics Co., Ltd. No. 7 Gongye 3rd Road, Shekou, Nanshan District Shenzhen,

			candles, indoor electric candles, outdoor electric candles, electric pillar candles, electric votive candles, electric taper candles	Guangdong 518067 CHINA
8.	WONDERGLOW	Advertised App 1893345 App 09-JUN-2017	Fireplace heating inserts	Innovative Glow Products LLC 1508 Elm Hill Pike Suite 108 Nashville, Tennessee 37210 UNITED STATES OF AMERICA
9.	POWERBURN	Registered Reg TMA887443 Reg 09-SEP-2014	Solid fire starters, matches, log carriers, artificial fireplace logs	5D REALITY INC. 1 Spring Street Vancouver BC V5K1B1
10.	POWERFLAME	Granted Reg PBRA3982 Date Granted 28-AUG-1987	Geranium (Geranium Cinereum)	Regan Reginald Carter UNITED KINGDOM

Answer: [Note: Even if Yes/No answer is incorrect, mark may still be given if candidate provides valid supporting explanation.]

No.	TRADEMARK	ANSWER
1.		Answer: - No. (1 mark) - Registration expunged for non-use. (1 mark)
2.	POWERBLAZE	Answer: - Yes. (1 mark) - Marks are similar in appearance and connotation/ideas suggested OR the goods are nearly identical. (1 mark) [Note: only one of the terms “appearance”, “connotation” or “ideas suggested” is required to receive the mark.]

3.		<p>Answer:</p> <ul style="list-style-type: none"> - No. (1 mark) - Marks differ significantly in appearance, sound and connotation/ideas suggested. (1 mark) [Note: only one of the terms “appearance”, “sound”, “connotation” or “ideas suggested” is required to receive the mark.]
4.		<p>Answer:</p> <ul style="list-style-type: none"> - No. (1 mark) - Marks differ in appearance and sound OR the goods are different. (1 mark) [Note: only one of the terms “appearance” or “sound” is required to receive the mark.]
5.	POWERFLICKER	<p>Answer:</p> <ul style="list-style-type: none"> - No. (1 mark) - Mark does not <u>consist of</u>, nor does it <u>so nearly resemble</u> as to be likely to be mistaken for, the official mark (1 mark) [Note: both underlined elements are required to receive the mark.]
6.	PWRFLME	<p>Answer:</p> <ul style="list-style-type: none"> - No. (1 mark) - The goods are different OR the channels of trade would be different. (1 mark)
7.	WONDERFLAME	<p>Answer:</p> <ul style="list-style-type: none"> - No. (1 mark) - The goods are different OR the channels of trade would be different. (1 mark)
8.	WONDERGLOW	<p>Answer:</p> <ul style="list-style-type: none"> - No. (1 mark) - Marks differ in appearance, sound and connotation/ideas suggested. (1 mark) [Note: only one of the terms “appearance”, “sound”, “connotation” or “ideas suggested” is required to receive the mark.]
9.	POWERBURN	<p>Answer:</p> <ul style="list-style-type: none"> - No. (1 mark) - Marks are owned by same entity OR the owner is the client. (1 mark)
10.	POWERFLAME	<p>Answer:</p> <ul style="list-style-type: none"> - No. (1 mark) - Mark does not cover a plant variety. (1 mark)

QUESTION 15 (12 marks)

Mr. Paul Johnson owns an ice cream parlour in Toronto by the name of SAYONARA. He is now thinking about retiring and selling his company, Sayonara Ice Cream Inc. He has found a potential buyer for his business and believes that he could sell it for a higher price if he owned a registered trademark. On January 7, 2019, Mr. Johnson filed the trademark SAYONARA himself, but the application has not yet been assigned to an examiner. Mr. Johnson now contacts you to ask if it would be possible to speed up the registration process of his mark. According to the Trademarks Database, the particulars of Mr. Johnson's application are as follows:

Application No.: 1,222,333
Filed: 2019-01-07

Trademark: SAYONARA
Type: word-mark
Category: trademark

Applicant:
Sayonara Ice Cream Inc.
123 Frost Street
Toronto

Goods: Ice cream, ice cream cakes, t-shirts, aprons and other promotional items.

Services: Ice cream parlours.

Claims: Used in Canada since 1983

- a) In order to avoid unnecessary delays during examination, Mr. Johnson asks you to review the application for SAYONARA to determine whether there are any amendments that can be made now to help avoid the issuance of an Examiner's report. List four items that will need to be addressed in order to avoid an Examiner's report (**4 marks**) and cite the relevant provisions of the *Trademarks Act* or *Trademarks Regulations* for each item (**4 marks**).

Answer:

- Provide an English or French translation of the word SAYONARA. (**1 mark**)
- Subsection 31(d) of the *Trademarks Regulations*. (**1 mark**)
- Provide the applicant's postal address. (**1 mark**)
- Subsection 31(a) of the *Trademarks Regulations*. (**1 mark**)
- Re-define the goods "other promotional items" in ordinary commercial terms. (**1 mark**)
- Paragraph 30(2)(a) of the *Trademarks Act* **OR** Section 29 of the *Trademarks Regulations*. (**1 mark**)
- Group the goods and services in accordance with the classes of the Nice Classification. (**1 mark**)

- Subsection 30(3) of the *Trademarks Act*. (1 mark)

b) Assuming you proceed with filing these amendments immediately, when will they be assessed by the Trademarks Office? (1 mark) Cite the relevant authority for your answer. (1 mark)

Answer:

- When the application is examined. (1 mark)
- Practice Notice dated June 17, 2019, "Amendments to trademark applications requested prior to examination". (1 mark)

[Note: Date and title of Practice Notice not required to receive the mark.]

c) Yes or No. (1 mark) Is it possible to expedite examination of the trademark application? Cite the relevant authority for your answer. (1 mark)

Answer:

- No. (1 mark)
- *Trademarks Examination Manual*, Section 2.2. (1 mark)

[Note: Particular section of the Examination Manual not required to receive the mark.]

QUESTION 16 (8 marks)

Your client, Suzie Bellamy, is the author of a series of children's books named HIDE AND SEEK STREET. The first book in this series was published in 2015 and was an instant success with preschoolers throughout Canada. In 2016, your client launched several promotional items bearing the HIDE AND SEEK STREET trademark and decided to file a trademark application for the mark with the Canadian Trademarks Office. The mark is now registered as follows:

Application No.: 1,789,789
Filed: 2016-07-03

Registration No.: 991,991
Registered: 2018-03-01

Trademark: HIDE AND SEEK STREET
Type: word-mark
Category: trademark

Applicant:
Suzie Bellamy
958 Pineview
Vancouver, BC

V5Z 1M9

Goods:

- (1) Children's books.
- (2) T-shirts, school bags, posters and colouring books.

Claims: Used in Canada since at least as early as December 2015 on goods (1).
Used in Canada since at least as early as June 2016 on goods (2).

In September 2018, Ms. Bellamy started selling her books and merchandise in several English-speaking countries. She has now launched an educational software application for tablets and smartphones and this application has quickly become one of the most downloaded educational applications in Canada, the United States, the United Kingdom, Ireland and Australia.

Ms. Bellamy contacts you because she would like to protect her trademark internationally for her books, merchandise and educational application, but she has a limited budget.

Taking into account your client's budgetary limitations, what would be the best strategy to adopt to ensure that Ms. Bellamy's trademark is fully protected in Canada and in the countries where her products are currently sold? Briefly explain the steps you would need to take and list the applications to file and the particulars of each application. **(8 marks)**

Answer:

- File a new Canadian application for the trademark HIDE AND SEEK STREET for "educational software application for tablets and smartphones" **OR** file an application to extend the statement of goods for registration No. 991,991 to add the goods "educational software application for tablets and smartphones". **(1 mark)**
- Classify the goods of Canadian registration No. 991,991 in accordance with the Nice Classification in order to file an International trademark application. **(1 mark)**
- File an International trademark application **(1 mark)** designating the United States, the United Kingdom, Ireland (**OR** the European Union) and Australia **(1 mark)** based on the existing Canadian registration No. 991,991 **(1 mark)** for "children's books, t-shirts, school bags, posters and colouring books" **(1 mark)** and based on the newly filed Canadian application (**OR** the application to extend the statement of goods) for "educational software application for tablets and smartphones". **(1 mark)**
- Claim priority of the newly filed Canadian application **OR** application to extend the statement of goods for "educational software application for tablets and smartphones". **(1 mark)**

QUESTION 17 (5 marks)

True or False. Putting aside any considerations of state of the Register or marketplace, the following trademarks would be considered to have no inherent distinctiveness:

- a) The representation of a cat-shaped balloon with a party hat for “cat toys”. (1 mark)
- b) WET for “bottled water”. (1 mark)
- c) LUCIE’S CARROT CAKE for “carrot cake”. (1 mark)
- d) 1-800-MUFFINS for “home delivery of fresh muffins”. (1 mark)
- e) MILLER DAVIS for “insurance services”. (1 mark)

Answer:

- a) False. (1 mark)
- b) True. (1 mark)
- c) False. (1 mark)
- d) False. (1 mark)
- e) False. (1 mark)

QUESTION 18 (4 marks)

Your client asked you to file a trademark application for ALIENINVASION for clothing. About 13 months later, you received an official letter requesting that the applicant provide further particulars of the term “clothing”. The client instructed you to respond by amending the goods to read “casual clothing” and you filed the response 4 months ago. Your client has now started using its mark on t-shirts and realizes that they prefer ALIEN INVASION as two words instead of one. They have asked you if it is possible to amend the application to reflect ALIEN INVASION as two words. Yes or No. (1 mark) Is it likely that the Trademarks Office will permit this amendment? Provide a one-sentence explanation for your answer. (2 marks) Cite the relevant provision of the *Trademarks Regulations*. (1 mark)

Answer:

- Yes. (1 mark)
- The application has not been advertised (1 mark) and the trademark remains substantially the same. (1 mark)
- Paragraph 35(2)(b) of the *Trademarks Regulations*. (1 mark)

QUESTION 19 (3 marks)

A trademark application was filed before June 17, 2019 for a word mark, without any statement that the mark consists of standard characters. Assuming no objections are raised, in one sentence explain how the application will be treated by the Examiner. (2 marks) Cite the relevant authority for your answer. (1 mark).

Answer:

- The trademark will be scanned (1 mark) and represented **OR** approved **OR** advertised as filed (1 mark).
- Practice Notice, dated June 17, 2019, on "Standard character trademarks". (1 mark)
[Note: the date and title of the Practice Notice is not required to receive the mark.]

QUESTION 20 (1 mark)

On June 20, 2019, you filed an International trademark application based on a Canadian trademark registered on March 26, 2015. The International trademark was registered on September 8, 2019. Until what date does the International trademark depend on the basic Canadian registration? (1 mark)

Answer:

- September 8, 2024. (1 mark)

QUESTION 21 (5 marks)

You filed an application on behalf of your client, claiming priority to its EU trademark application. The Canadian application has been advertised, and you forwarded a copy of the advertisement to your client. In speaking with the client, you learn that the EU trademark application is actually in the name of a company related to the Canadian applicant, but not a predecessor-in-title to the Canadian applicant.

- a) True or False. (1 mark) A Canadian trademark application cannot claim priority to an EU trademark application. Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

- False. (1 mark)
- Subsection 34(1) of the *Trademarks Act*. (1 mark)

- b) True or False. (1 mark) You can withdraw the priority claim. Cite the relevant provision of the *Trademarks Act* (1 mark) and of the *Trademarks Regulations*. (1 mark)

Answer:

- False. (1 mark)
- Subsection 34(4) of the *Trademarks Act* (1 mark) and Subsection 33(2) of the *Trademarks Regulations*. (1 mark)

QUESTION 22 (4 marks)

A U.S. certifying body that holds registrations for its certification mark in the U.S. and certifies the goods under the mark in the U.S. would like to file for its certification mark in Canada, but the mark is not yet in use in Canada. Yes or No. (1 mark) Can the U.S. certifying body obtain protection for its mark in Canada as a certification mark if the mark is not yet in use in Canada? What are the requirements for application for registration of a certification mark under the *Trademarks Act* specific to certification marks and not to other types of marks. (2 marks) Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

- Yes. (1 mark)
- Particulars of the defined standard. (1 mark)
- A statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of the goods in association with which the certification mark is proposed to be used. (1 mark)
- Paragraph 30(2)(b) of the *Trademarks Act*. (1 mark)

QUESTION 23 (3 marks)

An application is filed online in association with "marble statues" in Class 19 and "statues made of common metal" in Class 6 together with a filing fee of \$330 and obtains a filing date. The application is subsequently revised to remove "statues made of common metal" from the application. Yes or No. (1 mark) Are any further fees required? Provide a brief explanation. (2 marks)

Answer:

- Yes. (1 mark)
- The application filing fee is determined based on the number of classes of goods and services in the application at the filing date (1 mark), so despite the subsequent removal of one class, the applicant would have to pay for two classes and not just one **OR** the applicant would have to pay an additional class fee of \$100. (1 mark)

QUESTION 24 (3 marks)

Your client is a U.S. trademark attorney, on whose instruction you have filed a number of Canadian trademark applications, on behalf of one of their clients (the applicant). You receive an e-mail from a U.S. attorney at a different firm, stating that they are taking over carriage of the applicant's trademark portfolio, and instructing you to communicate only with them going forward in connection with the applicant's Canadian trademark matters.

Neither your client, nor the applicant, is copied on this e-mail. Briefly explain how you should handle this situation and why. **(3 marks)**

Answer:

- Confirm with your existing client (the original U.S. trademark attorney) that you are to correspond only with the new U.S. attorney going forward. **(1 mark)**
- The first U.S. attorney is your client **(1 mark)**, and you must have instructions from your client before divulging any confidential information to the new U.S. attorney. **(1 mark)**

QUESTION 25 (19 marks)

You filed an application for registration of the mark CANADA FRESH on behalf of your Canadian client, CF Limited, on June 18, 2019, for:

Class 16: “books and periodical publications”;

Class 25: “casual clothing and casual footwear”;

Class 30: “meat and cheese; bread, pasta and pastry”;

Class 31: “unprocessed raw fruits and vegetables”; and

Class 32: “fruit juice”.

Your client informs you that the trademark has been used in Canada in association with these goods since 2012, and that all of its goods are manufactured in Canada.

The application has been examined and the Examiner has issued the following Office Action:

26 Oct 2019
Your File
123-456789
Our File
1970200

Your Firm
Somewhere in Canada

Re: Trademark: CANADA FRESH
Applicant: CF Limited

This examiner's report concerns the above-identified application. To avoid abandonment proceedings, a proper response must be received by this office by April 26, 2020. All correspondence respecting this application must indicate the file number.

The applicant is requested to confirm that the associated goods originate from CANADA, as research shows that this word is primarily a geographic name. Goods

originate from a geographic location if they are manufactured, produced, grown, assembled, or designed there.

If the goods do not originate from CANADA, then the trademark as a whole deceptively misdescribes the place of origin of the goods. The average Canadian consumer or dealer would be misled into the belief that the associated goods originate from CANADA, and therefore the trademark is unregistrable pursuant to paragraph 12(1)(b) of the *Trademarks Act*.

If, however, the goods originate from CANADA, then the trademark as a whole clearly describes the character and place of origin of the following associated goods, namely, meat, cheese, bread, pasta, pastry, unprocessed raw fruit and vegetables and fruit juice, and is therefore unregistrable pursuant to paragraph 12(1)(b) of the *Trademarks Act*. Specifically, the trademark clearly describes that the applicant's goods are fresh meat, cheese, bread, pastry, fruit, vegetables and fruit juice that originate from Canada.

Alternatively, if these goods are not fresh, then the trademark is considered to be deceptively misdescriptive.

Therefore, in view of the provisions of paragraph 12(1)(b) of the *Trademarks Act*, the trademark does not appear registrable.

Furthermore, pursuant to paragraph 37(1)(d) of the *Trademarks Act*, it appears that the trademark is not distinctive.

The Registrar's preliminary view is that the trademark is not inherently distinctive for the aforementioned goods, namely, meat, cheese, bread, pasta, pastry, unprocessed raw fruit and vegetables and fruit juice, as trademarks which do not appear registrable pursuant to paragraph 12(1)(b) of the *Trademarks Act* are considered not inherently distinctive.

In particular, the subject trademark does not distinguish the goods of the applicant from those of another person or business in that the trademark clearly describes the character and place of origin of the applicant's goods, namely that the goods are fresh and originate from Canada. As such, the consumer would not be able to distinguish the source of the applicant's goods from those of a competitor since the applied-for trademark is merely a generic description of a particular characteristic and place of origin of the goods.

Therefore, pursuant to paragraph 32(1)(b) of the *Act* the applicant is required to furnish the Registrar with evidence establishing that the trademark was distinctive at the filing date of the application for its registration. Please note that pursuant to subsection 32(2) of the *Act*, the Registrar shall, having regard to the evidence adduced, restrict the registration to the goods in association with which, and to the defined territorial area in Canada in which, the trademark is shown to be distinctive.

Any comments you may wish to submit will receive consideration.

If the applicant has any specific questions in respect of this office action, please contact the assigned examiner.

Yours truly,

Anita Bev Orage
Examination Section

- a) Assuming your client is interested in obtaining a registration for its CANADA FRESH mark as soon as possible, what steps do you recommend that your client take. (5 marks)

Answer:

- File a revised application limiting the goods to those in Classes 16 and 25 **OR** “books and periodical publications; casual clothing and casual footwear”. (1 mark)
- File a divisional application for the goods in Classes 30, 31 and 32 **OR** “meat and cheese; bread, pasta and pastry; unprocessed raw fruits and vegetables; fruit juice” **OR** the goods subject to the not inherently distinctive objection. (1 mark)
- Reply to the Office Action, confirming that all the goods originate from Canada **OR** are manufactured in Canada. (1 mark)
- Point out that the original application (covering the goods in Classes 16 and 25) is now in order to be approved for advertisement **OR** should now be permitted to proceed. (1 mark)
- Respond to the Office Action with respect to the divisional application by filing evidence showing that the mark was distinctive as of the filing date in connection with the goods in Classes 30, 31 and 32 covered by the divisional application **OR** request an extension of time to respond to the Office Action with respect to the divisional application covering the goods in Classes 30, 31 and 32 to allow sufficient time to compile evidence of distinctiveness. (1 mark)

- b) In preparing the affidavit evidence pursuant to Subsection 32(1) of the *Trademarks Act*, assuming that you will be filing a company affidavit sworn/affirmed on behalf of CF Limited, list, in point form, the most important information and/or documents to be included in the affidavit. (10 marks)

Answer:

- The full name and title of the person swearing/affirming the affidavit. (1 mark)
- Explanation of basis and source of person’s knowledge. (1 mark)
- Particulars of the applicant company. (1 mark)

- a statement of the nature of use of the trademark in association with all of the goods. (1 mark)
- an explanation of the manner of association of the trademark at the time of transfer of property or transfer in the possession of goods (1 mark), and specimens [or any word that suggests specimens] of the trademark as used in association with the goods. (1 mark)
- an explanation of the manner of use of the trademark in the advertisement of goods (1 mark), and specimens of advertising material. (1 mark)
- statements which clearly indicate the extent of use of the trademark for each defined territorial area [or each province/territory] in which the trademark is stated to have become distinctive. (1 mark)
- information as to the length of time the trademark has been used in Canada in association with the goods. (1 mark)

- c) In view of the objection pursuant to Paragraph 12(1)(b) of the *Trademarks Act*, other than Paragraph 32(1)(b), cite the other two provisions of the *Trademarks Act* relevant to the distinctiveness claim. (2 marks)

Answer:

- Subsections 12(3) (1 mark) and 32(1)(a) of the *Trademarks Act*. (1 mark)

- d) You were not able to collect all of the necessary evidence within the initial six months, and so requested the permissible six-month extension of time to respond to the outstanding Office Action. The extended deadline is now looming, and you still do not have all the necessary evidence together. True or False. (1 mark) Your client can obtain a further extension of time, based on exceptional circumstances, to finish compiling its evidence. Cite the relevant authority for your answer. (1 mark)

Answer:

- False. (1 mark)
- Trademarks Examination Manual, Section 6.8.1. (1 mark) **[Note: Particular section of the Examination Manual not required to receive the mark.]**

QUESTION 26 (3 marks)

Your firm, IP Fuel Trademark Services, has been asked to respond to an Office Action in connection with an application by Awesome Ski Clothing Ltd. to register the trademark STORM VALLEY for ski clothing. The Office Action cites the registered trademark for STORM CANYON, below. What do you advise Awesome Ski Clothing Ltd. (2 marks) Cite the relevant authority. (1 mark)

STORM CANYON — 16245438

Application number
16245438

Registration number
TMA937032

Type(s)
Word

Category
Trademark

CIPO status
REGISTERED

Filed
2013-04-23

Registered
2016-05-10

Registration Expiry Date
2031-05-10

Current owner
SKI Trading Company, Inc.
624 SKI Blvd. the Skihill,
CANADA

Agent
IP FUEL TRADEMARK
SERVICES
Ottawa City P.O. BOX 0,
CANADA

Index headings
STORM CANYON

Goods
(1) Clothing, namely, men's, women's, and children's T-shirts, shirts, tops, sweatshirts, sweatpants, pants, side zip pants, shorts, vests, parkas, anoraks, coats, jackets, wind-resistant jackets, jacket hoods, pullovers, sweaters; outerwear, namely, shells, ski wear, ski vests, ski jackets, snowboard wear, snow pants, rain wear, rain jackets, rain pants; headgear, namely, hats, beanies.

Classification data

Disclaimer

The classification data is provided for information and searching purposes only. CIPO does not warrant the accuracy of the classes assigned to the trademark. This data has no legal value of any kind.

25 - Clothing, footwear, headgear

Registrant

Welch Apparel Group, Inc.
624 Spiral Blvd. Hastings, MN
55033 UNITED STATES OF
AMERICA

Applicant**Action History**

Action	Action date	Due date	Comments
Filed	2013-04-23		
Created	2013-04-24		
Formalized	2013-04-25		
Search Recorded	2014-01-14		
Approval Notice Sent	2014-01-14	2014-02-11	
Approved	2014-03-06		APPROVED BY PROGRAM EX200M1
Advertised	2014-03-12		Vol.61 Issue 3098
Allowed	2014-06-27		
Allowance Notice Sent	2014-06-27	2016-04-23	
Registered	2016-05-10	2031-05-10	

Answer:

- You cannot submit arguments to try to overcome the confusion citation, since your firm is agent for the cited mark **(1 mark)**, and that would be a conflict of interest. **(1 mark)**
- *Intellectual Property Institute of Canada Code of Ethics* **OR** Rules of Professional Conduct of the provincial law societies. **(1 mark)**

TRADEMARK AGENT EXAM 2019
PAPER B
Total Marks: 150

QUESTION 1 (17 MARKS)

You represent the applicant in trademark opposition proceedings. You have received the affidavit below from the very recently appointed agent for the opponent, served upon you one day late. This affidavit forms the entirety of the opponent's Section 50 evidence. The affidavit has exhibits but they are not reproduced below.

The affidavit directly addresses the issue of confusion between the marks JAVELO and JAVEX, as alleged by the opponent.

IN THE CANADIAN INTELLECTUAL PROPERTY OFFICE

IN THE MATTER OF an Opposition by 5678 Canada Inc. (the "**Opponent**") to Application No. 1,888,881 for the trademark "JAVELO" filed by 1234 Ontario Inc. (the "**Applicant**") and advertised in the February 21, 2018 issue of the *Trademarks Journal*.

AFFIDAVIT OF JUSTINE SMITH

I, **JUSTINE SMITH**, of the City of Vancouver, Province of British Columbia, Canada,
MAKE OATH AND SAY:

1. I am the Vice-president of Marketing and an Officer of 5678 Canada Inc. ("**my company**"), a position for which I was hired in 2019 from another company. I am authorized by my company to make this affidavit in support of this opposition.
2. Now shown to me and attached as **Exhibit "A"** to this affidavit is a Certificate of Incorporation for my company generated on April 23, 2009 by the Province of British Columbia, Ministry of Government Services.
3. The trademark JAVEX is also the subject of litigation between the Opponent and the Applicant. Now shown to me and attached as **Exhibit "B"** to this affidavit is the Statement of Defence and Counterclaim of the Applicant, Court File No. CV-15-12345 dated October 11, 2015.
4. Continuously from the incorporation of my company on or about April 28, 2002 to the present, my company has used the trademark and trade name JAVEX in association with cleaning services in Canada, namely residential and commercial cleaning services including as described below. These services are provided in British Columbia including the Greater Vancouver Area.
5. Now shown to me and attached as **Exhibit "C"** to this affidavit is a bundle of representative invoices for cleaning services that would have been issued by my company to clients at the job site between April 2002 to the present.

6. Now shown to me and attached as **Exhibit “D”** to this affidavit is a representative invoice for cleaning services that would have been issued by my company to clients by mail between April 2009 to the present after the completion of a job. The text that includes JAVEX is replicated exactly below.

Javex Inc.
123 Street
Vancouver, BC

7. Now shown to me and attached as **Exhibit “E”** to this affidavit is a photograph of a shirt that employees of my company wear while performing cleaning services for customers. This shirt is representative of the shirts that the employees wore from 2007 until the present. It is common for customers to be present for part of the time when the employees perform cleaning services.
8. I have been advised by my company’s accounting department, that the revenues generated by my company for the services associated with the trademark in Canada in each of the years since 2010 have been in excess of \$500,000, and within the past couple of years sales have been in excess of \$1,300,000.
9. Since the incorporation of my company and to the present, my company has provided cleaning services in Canada to over 15,000 customers in association with the trademark and trade name JAVEX including as described above.

SWORN BEFORE ME at the City of)
Vancouver, in the Province of British)
Columbia this 15th day of July, 2019)

JUSTINE SMITH

A Commissioner for taking Affidavits, etc.

- a) You have received a request from the agent for the opponent for consent to an extension of time of one (1) day to file the opponent’s evidence. This is the first request for an extension of time in these proceedings from either party. You have a highly responsive client that is able to provide you with instructions as needed. This is a hard-fought opposition and your client does not wish to consent to the extension of time. Yes or no, should you nevertheless recommend that your client consent to the extension of time? **(1 mark)**
- b) Provide a brief reason for your answer above. **(1 mark)**

- c) If your client does not consent to the extension of time, what should the opponent do to be permitted to file the evidence. This request for permission has three (3) components that the opponent needs to consider. **(3 marks)**
- d) In deciding whether to cross-examine the affiant identify one (1) risk of not conducting the cross-examination. **(1 mark)**
- e) In deciding whether to cross-examine the affiant identify one (1) risk of conducting the cross-examination. **(1 mark)**
- f) Your client, upon being served with the opponent's evidence, would like to request an order for cross-examination and an extension of time to file the applicant's evidence. What are two (2) factors that the applicant should consider when making the request? **(2 marks)**
- g) What will happen to the applicant's deadline for filing and serving its section 52 evidence if the applicant is in default of completing the cross-examination? **(1 mark)**
- h) When asking questions in a cross-examination, what form should the questions ideally take? A. Open-ended questions. B. Closed-ended questions. **(1 mark)**
Explain why. **(1 mark)**
- i) Identify five (5) relevant cross-examination questions that you, as the applicant's agent, could ask the affiant that would likely assist the applicant's case. Only the first five answers will be marked. **(5 marks)**

QUESTION 2 (15 MARKS)

Your client, HG Inc., is a Canadian gin manufacturer that owns registration No. TMA588,888 for the trademark HECTOR GIN in association with the goods "alcoholic beverages, namely gin". Your client's mark issued to registration on January 11, 2012 and your client has used the mark in Canada since at least as early as June 4, 2009.

Your client has expressed interest in opposing the following application, which was advertised in the *Trademarks Journal* on June 10, 2019:

Trademark: HEKTOR

Applicant: Maxwell Smith

For use in association with the goods "non-alcoholic beverages, namely tonic water"

The application claims proposed use in Canada.

Before the initial expiration of the advertisement period on August 10, 2019, your client instructed you to request a six-month extension of time to oppose the application, amounting to a cooling-off period, to allow for the possibility of resolving the matter by way of settlement. During settlement discussions, it was disclosed that Maxwell Smith is not the owner of the applicant business nor is he involved in the business, he simply filed the application on behalf of his brother, David Smith, who is the president of the

applicant's business. Thereafter, settlement negotiations were only held between your client and David Smith.

Your client currently faces a deadline of February 10, 2020 to file a statement of opposition. On February 2, 2020, following unsuccessful settlement negotiations, your client instructed you to proceed with the preparation and filing of a statement of opposition.

- a) Based on the information available and excluding any issues relating to the confidentiality of any disclosures, identify the four (4) strongest grounds of opposition by citing the relevant provisions of the *Trademarks Act* **(8 marks – 1 mark for each of the relevant provisions)**. For each ground alleged, state the necessary fact(s) justifying your selection. **(4 marks - 1 mark per ground) (total: 12 marks)**
- b) You proceed to file your client's statement of opposition and the Registrar subsequently forwards the statement of opposition to the applicant on February 10, 2020. On April 3, 2020, the applicant files and serves its counterstatement, which is accompanied by a request for an interlocutory ruling (IR) to strike portions of the statement of opposition. Will the Registrar request your comments on this IR? Yes or No. **(1 mark)** Provide a brief explanation for your answer **(1 mark)** and cite the relevant provision of the *Trademarks Act*. **(1 mark)**

QUESTION 3 (3 MARKS)

The following questions relate to opposition proceedings.

- a) True or False. An opponent, when alleging a ground of opposition under paragraph 12(1)(d) of the *Trademarks Act*, may rely on a registered trademark standing in the name of a third party. **(1 mark)**
- b) True or False. In accordance with the provisions of the *Trademarks Act*, RSC 1985 c T-13 as amended June 17, 2019, in an appeal to the Federal Court of a decision by the Registrar, new evidence may be brought as of right. **(1 mark)**
- c) True or False. In accordance with the provisions of the *Trademarks Act*, RSC 1985 c T-13 as amended June 17, 2019, a statement of opposition must be filed in duplicate. **(1 mark)**

QUESTION 4 (2 MARKS)

Your client wishes to oppose an application, which was advertised on September 15, 2019. Based on the information available, an allegation of 'bad faith' by the applicant will be the key ground of opposition. What ground of opposition will need to be pleaded? **(1 mark)**. Cite the relevant provision of the *Trademarks Act*. **(1 mark)**

QUESTION 5 (14 MARKS)

The following true or false questions relate to section 45 proceedings. For each true or false answer, support your answer with the most specific applicable authority (section of the *Trademarks Act* or *Trademarks Regulations* or Practice Notice) where applicable. If there is no authority, state so.

- a) The requesting party has four months within which to file its evidence after the registered owner has filed its evidence in response to a section 45 notice. **(2 marks)**
- b) Any person who pays the prescribed fee may file a written request asking the Registrar to forward a section 45 notice to the registered owner of a trademark that has been registered for a period of three or more years. **(2 marks)**
- c) Service of evidence in section 45 proceedings may be effected by personal service, registered mail, fax, or email. **(2 marks)**
- d) The requesting party must copy the registered owner of a trademark on its request asking the Registrar to initiate section 45 proceedings. **(2 marks)**
- e) The party that requested that the Registrar send a section 45 notice (the requesting party) pays all costs associated with cross-examination of an affiant during the proceeding. **(2 marks)**
- f) If the Registrar receives a written request to initiate section 45 proceedings against a registration that is already the subject of a section 45 proceeding for which a decision has issued and is currently under appeal, the Registrar may decide not to issue a section 45 notice. **(2 marks)**
- g) The Registrar has discretion to issue a section 45 Notice prior to the mark having been registered for three years. **(2 marks)**

QUESTION 6 (10 marks)

On behalf of your client, you requested the issuance of a section 45 notice against registration No. TMA135,246 for the trademark GOAT in association with the goods “watches, ankle bracelets, sunglasses, t-shirts”, and the services “restaurant services”.

In response to this notice, which was issued by the Registrar on July 5, 2019, the owner of the registration, ABC Inc., filed the following affidavit:

TO: The Registrar of Trademarks

IN THE MATTER OF a Section 45 Proceeding
regarding Canadian Registration No.
TMA135,246 for the trademark GOAT in the
name of ABC Inc.

AFFIDAVIT OF JOHN JONES

I, John Jones, of the City of Ottawa, in the Province of Ontario, in Canada, hereby
MAKE OATH AND SAY:

1. I am the President of ABC Inc. (the “Registrant”), an Ontario corporation whose principal place of business is located at 23 Acorn Street, Ottawa, Ontario, Canada.
2. I have held this position since 2009.
3. I am authorized to make this affidavit, and all statements I make herein are either from my personal knowledge or derived from the records of the Registrant which are maintained in the ordinary course of business.
4. During the period from July 5, 2016 to July 5, 2019 (the “Relevant Period”), ABC Inc. sold watches bearing the trademark GOAT to retailers in Canada. Attached as Exhibit A to my affidavit is a photograph of a watch that is representative of the watches that ABC Inc. sold during this period [*Exhibit A shows a watch with the word GOAT printed on the middle of the watch face*]. ABC Inc. also sold ankle bracelets. Attached as Exhibit B to my affidavit is a photograph that is representative of ABC Inc.’s current line of ankle bracelets [*Exhibit B shows an ankle bracelet with the word GOAT etched on the clasp of the bracelet*].
5. ABC Inc. has sold its watches and jewellery, including the watches shown in Exhibit A, and various ankle bracelets, to local Ottawa-area jewellery stores. Attached as Exhibit C is a spreadsheet displaying sales transactions to these jewellery stores during the Relevant Period [*Exhibit B shows over 300 sales transactions and details including the dates of sale, names of the Ottawa-area retailers that purchased the watches and ankle bracelets, invoice numbers for the watches, and pricing. All transactions are dated during the Relevant Period*].
6. Since 2014, ABC Inc. has been advertising its sunglasses in various newspapers, including the local Ottawa area newspaper. Attached as Exhibit D is a representative sample of these advertisements [*Exhibit D shows a newspaper advertisement that reads “GOAT sunglasses – get on over and pick up a pair!”*].
7. ABC Inc. has had sales in excess of \$100,000 CAD of its GOAT t-shirts to Canadian retailers during the Relevant Period. Attached as Exhibit E to my affidavit is a photograph of a t-shirt that is representative of the type of shirt sold during the Relevant Period [*Exhibit E shows a t-shirt bearing a label with the word GOATEE as*

one word and in capital letters in the same size and font. No other markings appear on the shirt].

8. ABC Inc. also operates a number of GOAT vegetarian restaurants in the Ottawa area. Attached as Exhibit F to my affidavit are representative photographs of the restaurant signage and restaurant uniforms worn by the waiting staff during the Relevant Period. *[Exhibit F consists of 1) a photograph of restaurant signage displaying a drawing of a goat, and 2) a photograph of a restaurant uniform with the word GOAT printed clearly on the front and back of the uniform].*

John Jones

SWORN BEFORE ME in the City of Ottawa, in the Province of Ontario, this 5th day of September 2019.

Jane Jensen

Commissioner for Taking Affidavits for the Province of Ontario
My commission does not expire.

In accordance with the questions below, for each of the goods and services listed in the registration, provide your client with an opinion on whether the registration will be maintained or expunged for those goods and services and briefly explain why. Base your opinion solely on the evidence provided, and the relevant principles of law. There is no requirement to cite case law unless specifically requested.

- a) For the goods “watches”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).
- b) For the goods “ankle bracelets”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).
- c) For the goods “sunglasses”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).

- d) For the goods “t-shirts”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).
- e) For the services “restaurant services”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).

QUESTION 7 (8 marks)

Your client, Rainbow Bikes Inc., has been using the trademark RAINBOW BIKES since January 2004 in association with its business involving the sale and servicing of bicycles. It has never obtained a trademark registration for RAINBOW BIKES and operates one bike shop in Gatineau, Quebec.

Your client recently received a demand letter from Cycling Strong Inc, which owns a Canadian registration for the trademark COLOURS OF THE RAINBOW. The COLOURS OF THE RAINBOW registration issued on April 15, 2017, based on alleged use of the mark in Canada since 2007, in association with: “travel services, namely, organising and leading bicycle trips”. Cycling Strong Inc. also owns a registration for RAINBOWS AND MORE. That registration issued on May 12, 2012 for: “clothing, namely, athletic shorts and tops; water bottles; messenger bags and backpacks”.

Cycling Strong Inc. is asking that Rainbow Bikes Inc. stop using the trademark and trade name RAINBOW BIKES in Canada. Your client is asking you for advice as to how to respond to this letter.

- a) After receiving the demand letter, Rainbow Bikes had an investigator see what it could find regarding the operations of Cycling Strong Inc. The investigator could not find any information regarding possible dates for future tours offered by Cycling Strong and all that the investigator could find, online, were photos of tours that took place in 2008 and 2009. It seems, however, that RAINBOWS AND MORE bags, tops and shorts are available for sale online at this time. On the basis of the above, what would you tell your client regarding the possible cancellation of the COLOURS OF THE RAINBOW registration and the RAINBOWS AND MORE registration, pursuant to section 45, including whether or not it would be possible to cancel each registration (**2 marks**) and the reasons why or why not. (**2 marks**)
- b) The investigator purchased one of the RAINBOWS AND MORE shirts. The label on the shirt shows the following: Wear it Proud Inc. Your client suspects that the mark might be used by an entity other than the owner of the registration. How might this affect your client’s position and why (**2 marks**)?

- c) The investigator has found that the COLOURS OF THE RAINBOW tours that were offered in 2008 and 2009 took place in Vancouver and in Saskatoon. Rainbow Bikes insists that it simply wants to continue using its mark and name in Gatineau. Can Cycling Strong Inc. rely on its registration to prevent the use of the mark RAINBOW BIKES in Ottawa? Yes or No (**1 mark**), and briefly explain your answer (**1 mark**) and cite the relevant provisions of the *Trademarks Act* in support of your answer (**2 marks**).

QUESTION 8 (10 marks)

Your client Flying High Inc. owns a registration for the trademark FLYING HIGH covering “confectionery, namely, gum drops”. The client filed its Declaration of Use on April 30, 2019 and the registration issued on May 15, 2019. Your client has received a Section 37(3) Notice from the Trademarks Office regarding an application for the trademark FLYING HIGH AS A KITE covering “non-alcoholic beverages, namely, fruit juices and spritzers”. That application is owned by Pie in the Sky Inc. The application is based on alleged use of the mark in Canada since at least as early as January 1, 2012 and was published for opposition on November 1, 2019.

- a) On a first review of these facts, would you recommend that your client consider opposing this application – yes or no? (**1 mark**) What fact is motivating your answer (**1 mark**) and provide the relevant statutory provision(s). (**2 marks**)
- b) It is difficult for you to obtain instructions from your client. What is the deadline by which you must oppose the application (**1 mark**) and can that deadline be extended (**1 mark**) and, if so, for how long (**1 mark**)?
- c) When opening a file for this matter, you realise that your firm has in the past represented Pie in the Sky Inc. in employment matters. List three things that you would do once you have that information in hand, along with the section 37(3) Notice (**3 marks**).

QUESTION 9 (2 MARKS)

Your client Bell Flowers Inc. owns a registration for HIGH FIVE covering “breads and rolls”. It would like to register the same mark for use in association with “granola, granola bars and cookies”. Your client’s registration issued over six months ago. Can the original registration be extended to cover those goods – yes or no? (**1 mark**) Cite the relevant section of the *Trademarks Act*. (**1 mark**)

QUESTION 10 (4 MARKS)

- a) The *Combating Counterfeit Products Act* amended six federal statutes. List three of them. (3 marks) Only the first three answers listed will be marked.
- b) The *Combating Counterfeit Products Act* generally prohibits the import and export of counterfeit goods. Identify one exception to this prohibition. (1 mark) Only the first answer will be marked.

QUESTION 11 (40 marks)

Your ultimate client, Radar Security S.A., is a Swiss company that specialises in security systems (motion detectors, cameras, door & window sensors, etc.), mostly for homes and small businesses, all sold under the trademark RADAR. However, you do not deal directly with Radar Security S.A., but rather with its Canadian subsidiary Radar Security Inc., that has a small office in Canada and a few sales agents in several major Canadian cities. Radar Security Inc. has a promotional website at www.radarsecurity.ca, which promotes all of Radar Security S.A.'s above-mentioned products and has been doing so since 2005. You may assume that there is a formal and valid licence authorising Radar Security Inc. to use the trademark RADAR in Canada.

Radar Security S.A. has recently developed a new service, under the trademark RADAR, which is a cloud based application that runs on Radar Security S.A.'s servers in Switzerland and is aimed at integrating a vast security system deployment in commercial (e.g. shopping malls) and industrial (e.g. factories) settings. This service, commonly known as Software as a Service "SaaS", was formally launched in September 2017 and has been promoted by Radar Security Inc. since the product launch, notably on its website and through brochures distributed to prospective clients. This new product was an immediate success in Europe and has been sold extensively in Europe since the launch. However, this SaaS has not yet been sold in Canada, notwithstanding serious efforts to commercialise it by having sales agents visit several potential clients, showing them how it works and what it is capable of achieving.

Radar Security S.A. is the owner of Canadian trademark application 2,233,445 for the trademark RADAR in association with the goods "*software for integrating and managing an array of security devices; monitors*". The application was filed in Canada on January 15, 2018 on the basis of registration and use in Switzerland and claims priority to an application filed in Switzerland on July 20, 2017 under number 987765. Application 2,233,445 is still pending, as you are trying to overcome an objection raised by the examiner on the basis of Canadian trademark registration TMA987,123 for the trademark SONAR in association with the goods "*security systems*", which issued to U.S. company Stars 'n' Stripes Protection Ltd. on November 23, 2016.

Stars 'n' Stripes Protection Ltd. sells the same type of products as Radar Security S.A. but its clientele is exclusively comprised of military, paramilitary and police forces, which is not a business sector of interest to Radar Security S.A. As there is no competition whatsoever between Radar Security S.A. and Stars 'n' Stripes Protection Ltd., and since there have been other instances of conflict between the marks RADAR and SONAR in other jurisdictions, Radar Security S.A. has taken the initiative of contacting Stars 'n' Stripes Protection Ltd. for the purposes of concluding a worldwide coexistence agreement. Discussions have been ongoing for over a year with not much progress and not much, if any, involvement on your behalf.

Radar Security S.A. does not own any other trademark applications or registrations in Canada.

In February 2019, you received the following e-mail from your client:

The guys in Switzerland just informed me that an application by Stars 'n' Stripes Protection Ltd. was just published (whatever that means) and sent me the following information (which I hope you'll understand as it doesn't mean much to me):

*Trademark: SONAR
Country: Canada
Applicant: Stars 'n' Stripes Protection Ltd.
Goods/services: software
Filing date: 2017-12-01
Filing basis: proposed use
Application No. 2,123,456
Status: Published 2019-02-06
Agent: Smith Tremblay Goldberg LLP, Toronto*

The guys want to know if there is anything you can do about this, you know, to get better leverage for their discussions with S'n'S. But they don't want to put too much into this, so try to keep it at a minimum.

I don't know if this is relevant, but I have never heard of S'n'S going into or offering any type of software. (I even asked one of my buddies who works there – should keep that to yourself, I don't want to get him into trouble – about this and he was surprised I even suggested that).

- a) In these circumstances, on what basis can it be argued that there is confusion between the trademarks RADAR and SONAR? Provide the two main factors to be considered. **(2 marks)**

- b) In view of your general instructions, you consider whether to file an opposition or request an extension of time to do so. What are the official fees for each? **(2 marks)**
Cite the authority. **(1 mark)**
- c) In light of the ongoing discussions between the parties, you recommended that your client request a nine-month extension of time, amounting to a cooling-off period. You requested said extension, which was granted by the Registrar. What was required in order for the Registrar to grant the extension of time? **(2 marks)** Cite the authority supporting your answer. **(1 mark)**
- d) The opposition deadline is in two weeks and the discussions between the parties have not been successful. You have therefore been instructed to proceed with the opposition. Which grounds of opposition can be considered: the pre-June 17, 2019 provisions of the *Trademarks Act* or the provisions in force since June 17, 2019? **(1 mark)** Cite the relevant provision of the *Trademarks Act* justifying your answer. **(1 mark)**
- e) Who is entitled to oppose the application, Radar Security S.A., Radar Security Inc. or both parties? **(1 mark)**
- f) Draft five (5) grounds of opposition that can reasonably be raised on the basis of the facts provided above. **(23 marks, i.e. 4 marks per ground – 6 marks for a particular ground that requires a more developed answer – for substance, reference to the appropriate provisions of the *Trademarks Act* and 1 mark for overall clarity and conciseness)** Only the first five grounds will be marked. No marks will be given for a ground of opposition based on suppositions or hopes that something may turn up in the evidence stage.
- g) How can the statement of opposition be served on Stars 'n' Stripes Protection Ltd.? **(1 mark)** Cite the relevant provision of the *Trademarks Act*. **(1 mark)**
- h) What's the best strategy could you recommend to overcome the objection raised on the basis of Stars 'n' Stripes Ltd.'s registration TMA987,123? **(2 marks)** Cite the authority for such a recommendation. **(2 marks)**

QUESTION 12 (3 marks)

Your client is in the business of well-aged wine and spirits. The client wants to launch a new wine under the trademark IL VINO DELL'AMORE and asked you to proceed with a trademark clearance search. The search revealed the following:

Trademark: IL VINO DELL'AMORE
Owner: Les vins Réginald Fafard & Fils Ltée
Goods/services: wine
Registration number: TMA246,357
Registration date: 1974-04-14
Agent: Smith Tremblay Goldberg LLP, Toronto

You reported to your client that this trademark registration posed an obstacle to registration of their proposed, subject to possible Section 45 proceedings to have the registration expunged for non-use (you never heard of that brand of wine and conducted a quick Internet search and found no recent reference to it). You therefore suggested to your client that it investigate a little further.

A week later, your client wrote back to you informing you that the only province in Canada where Les vins Réginald Fafard & Fils Ltée ever sold its wine IL VINO DELL'AMORE was in Québec. Your client also informs you that the wine in question was discontinued over three years ago and provides you with publicly available information from the Société des Alcools du Québec (or SAQ, the provincial liquor board) showing without a doubt that the last shipment of IL VINO DELL'AMORE wine was for 175 cases (of 12 bottles) sold and delivered on October 25, 2016.

In this context, do you recommend that your client immediately initiate summary cancellation proceedings pursuant to Section 45 of the *Trademarks Act*? Yes or no. **(1 mark)** Provide the elements supporting your recommendation. **(2 marks)**

QUESTION 13 (10 marks)

Match the case name with the most applicable legal principle. You have been provided with more legal principles than cases. Only one principle should be paired with one case. If you provide multiple principles for a case, only the first legal principle will be marked.

Case Name	Principle
A. <i>Nissan Canada Inc v BMW Canada Inc</i> , 2007 FCA 255 (the "M" mark case)	1. It is undoubtedly a famous trade-mark that deserves wide protection not only from free-riders but from those who, without any intention of free-riding, nevertheless use in their own business distinguishing marks that create confusion or depreciate the value of the goodwill attaching to those of the appellant.
B. <i>Bojangles' International LLC v Bojangles Café Ltd</i> , 2006 FC 657	2. If a mark was used differently than registered, the issue is, was the mark used in such a way that the mark did not lose its identity and remained

	recognizable in spite of the difference between the form in which it was registered and the form in which it was used.
C. <i>Promafil Canada Ltd v Munsingwear Inc</i> (1992), 44 CPR (3d) 59 (FCA)	3. A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient.
D. <i>Scott Paper Limited v Smart & Biggar</i> , 2008 FCA 129	4. If the wares or services originate in the place referred to by the trade-mark, then the trade-mark is clearly descriptive of place of origin.
E. <i>Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée</i> , 2006 SCC 23	5. The general rule is that absence of use is penalized by expungement.
F. <i>Masterpiece Inc v Alavida Lifestyles Inc</i> , 2011 SCC 27	6. It is worth bearing in mind that the number of items in the Trade Mark description are relatively few, so that it would not have required a great deal of trouble to "show" examples for each of them. This would not be requiring evidentiary overkill.
G. <i>MC Imports Inc v AFOD Ltd</i> , 2016 FCA 60 (the LINGAYEN mark case)	7. What subsection 45 requires is an affidavit or statutory declaration not merely stating but "showing", that is to say, describing the use being made of the trade mark within the meaning of the definition of "trade mark" in section 2 and of "use" in section 4 of the Act. The subsection makes this plain by requiring the declaration to show with respect to each of the wares and services specified in the registration whether the trade mark is in use in Canada and if not the date when it was last used and the reason for the absence of such use since that date.
H. <i>Uvex Toko Canada Ltd v Performance Apparel Corp</i> , 2004 FC 448 (the HOT CHILLY'S mark case)	8. A variant of the registered mark will constitute use of the registered mark providing the variant is not substantially different from the registered design.
I. <i>Canada (Registrar of Trade-marks) v Cie Internationale pour l'informatique CII Honeywell</i>	9. Statutory passing off under section 7(b) does not require a party to demonstrate that there is a trademark within the

<i>Bull, SA</i> (1985), 4 CPR (3d) 523 (FCA)	meaning of section 2 of the Trademarks Act.
J. <i>Plough (Canada) Ltd v Aerosol Fillers Inc</i> (1980), 53 CPR (2d) 62 (FCA)	10. For the use of a mark in advertisement and promotional material to be sufficiently associated with a ware to constitute use, the advertisements and promotion material would have to be given at the time of transfer of the property in or possession of the wares.
	11. The location where a mark is used is irrelevant when considering the likelihood of confusion between an applied for or registered trade-mark and a prior unregistered trade-mark or trade-name.
	12. The nature of wares or services should have less weight in a confusion analysis because the famous mark more likely will lead to the inference that the source of the two is the same.

QUESTION 14 (3 MARKS)

You represent a client who has an ongoing “feud” with one of its competitors. Your client has asked that you file applications for marks that are similar to the marks of this competitor, even if your client has no intention of ever using those marks, but only in order for its competitor to spend time and money opposing those applications and guarding against your client. This situation has been going on for a while and you consider this behaviour to be incongruous with your duties as a trademark agent.

- a) Can you unilaterally withdraw your services from this client? **(1 mark)** Explain why. **(1 mark)**
- b) Regardless of your previous answer, what would you need to do in order to withdraw your services? **(1 mark)**

QUESTION 15 (6 MARKS)

Your client, ABC Inc., a federally incorporated corporation (“ABC”), is an up and coming handbag manufacturer established in May 2016 and based in Toronto, Ontario. ABC prominently displays its trademark SMOKY ALLEGRETTO on all of its handbags. These handbags are currently offered for sale and sold through ABC’s retail stores in Vancouver, Calgary, Toronto, Montreal, and Halifax. ABC also sells its SMOKY ALLEGRETTO handbags to consumers across Canada through its company website.

ABC recently attended a Western Canada Fashion Accessories Exhibition in Calgary, Alberta. At the Exhibition, ABC learned that a new handbag manufacturer, 123789 Ltd., just set up a pop-up store in Calgary offering for sale and selling women's purses in association with the near identical trademark SMOKY ALLEGRETTOS. Apparently, this pop-up store has been very successful and 123789 Ltd. is planning to open more pop-up stores in Calgary and Vancouver within the next six months. Your client is very concerned and has come to you for advice.

Given that your client does not own a registration for its trademark SMOKY ALLEGRETTO, you advise your client that it is not eligible to bring an action for trademark infringement under section 20 of the *Trademarks Act*. However, you explain that is possible to bring an action for passing off against 123789 Ltd. Please provide brief answers to the following questions.

- a) In what jurisdiction(s) [and specifically, in which courts] can the client validly bring a passing-off action? **(3 marks)**
- b) List the necessary elements of a passing-off action involving a trademark. **(3 marks)**

QUESTION 16 (3 MARKS)

Your client instructs you on November 25, 2019 to urgently renew registration No. TMA987,123 that expires on the same day. The registration covers "cosmetics, t-shirts and mugs" and the goods are not currently grouped according to the Nice Classification. Your client only wants to renew the registration for "cosmetics" and you therefore proceed with the online renewal and pay the renewal fee for one Class (\$400).

Describe how the Trademarks Office will process the renewal. **(3 marks)**

TRADEMARK AGENT EXAM 2019
PAPER B
Total Marks: 150

QUESTION 1 (17 MARKS)

You represent the applicant in trademark opposition proceedings. You have received the affidavit below from the very recently appointed agent for the opponent, served upon you one day late. This affidavit forms the entirety of the opponent's Section 50 evidence. The affidavit has exhibits but they are not reproduced below.

The affidavit directly addresses the issue of confusion between the marks JAVELO and JAVEX, as alleged by the opponent.

IN THE CANADIAN INTELLECTUAL PROPERTY OFFICE

IN THE MATTER OF an Opposition by 5678 Canada Inc. (the "**Opponent**") to Application No. 1,888,881 for the trademark "JAVELO" filed by 1234 Ontario Inc. (the "**Applicant**") and advertised in the February 21, 2018 issue of the *Trademarks Journal*.

AFFIDAVIT OF JUSTINE SMITH

I, **JUSTINE SMITH**, of the City of Vancouver, Province of British Columbia, Canada,
MAKE OATH AND SAY:

1. I am the Vice-president of Marketing and an Officer of 5678 Canada Inc. ("**my company**"), a position for which I was hired in 2019 from another company. I am authorized by my company to make this affidavit in support of this opposition.
2. Now shown to me and attached as **Exhibit "A"** to this affidavit is a Certificate of Incorporation for my company generated on April 23, 2009 by the Province of British Columbia, Ministry of Government Services.
3. The trademark JAVEX is also the subject of litigation between the Opponent and the Applicant. Now shown to me and attached as **Exhibit "B"** to this affidavit is the Statement of Defence and Counterclaim of the Applicant, Court File No. CV-15-12345 dated October 11, 2015.
4. Continuously from the incorporation of my company on or about April 28, 2002 to the present, my company has used the trademark and trade name JAVEX in association with cleaning services in Canada, namely residential and commercial cleaning services including as described below. These services are provided in British Columbia including the Greater Vancouver Area.

5. Now shown to me and attached as **Exhibit “C”** to this affidavit is a bundle of representative invoices for cleaning services that would have been issued by my company to clients at the job site between April 2002 to the present.
6. Now shown to me and attached as **Exhibit “D”** to this affidavit is a representative invoice for cleaning services that would have been issued by my company to clients by mail between April 2009 to the present after the completion of a job. The text that includes JAVEX is replicated exactly below.

Javex Inc.
123 Street
Vancouver, BC

7. Now shown to me and attached as **Exhibit “E”** to this affidavit is a photograph of a shirt that employees of my company wear while performing cleaning services for customers. This shirt is representative of the shirts that the employees wore from 2007 until the present. It is common for customers to be present for part of the time when the employees perform cleaning services.
8. I have been advised by my company’s accounting department, that the revenues generated by my company for the services associated with the trademark in Canada in each of the years since 2010 have been in excess of \$500,000, and within the past couple of years sales have been in excess of \$1,300,000.
9. Since the incorporation of my company and to the present, my company has provided cleaning services in Canada to over 15,000 customers in association with the trademark and trade name JAVEX including as described above.

SWORN BEFORE ME at the City of)
Vancouver, in the Province of British)
Columbia this 15th day of July, 2019)

JUSTINE SMITH

A Commissioner for taking Affidavits, etc.

- a) You have received a request from the agent for the opponent for consent to an extension of time of one (1) day to file the opponent’s evidence. This is the first request for an extension of time in these proceedings from either party. You have a highly responsive client that is able to provide you with instructions as needed. This is a hard-fought opposition and your client does not wish to consent to the extension of time.

Yes or no, should you nevertheless recommend that your client consent to the extension of time? **(1 mark)**

Answer:

- Yes. **(1 mark)**

b) Provide a brief reason for your answer above. **(1 mark)**

Answer:

- The extension will likely be granted even without consent **(1 mark)** **OR** the extension does not prejudice your client **(1 mark)** **OR** your client may need an extension of time later in the proceedings **(1 mark)**.

c) If your client does not consent to the extension of time, what should the opponent do to be permitted to file the evidence. This request for permission has three (3) components that the opponent needs to consider. **(3 marks)**

Answer:

- Apply for a retroactive extension of time pursuant to subsection 47(2) of the *Trademarks Act* **(1 mark)** accompanied by the prescribed fee **OR** accompanied by \$125 **(1 mark)** using the recent change in trademark agent as a basis for the request **(1 mark)**.

d) In deciding whether to cross-examine the affiant identify one (1) risk of not conducting the cross-examination. **(1 mark)**

Answer:

- Failure to cross-examine on the affidavit leaves the evidence uncontested and may add weight to the opponent's evidence **OR** may preclude the applicant from challenging the evidence at the argument stage. **(1 mark)**

e) In deciding whether to cross-examine the affiant identify one (1) risk of conducting the cross-examination. **(1 mark)**

Answer:

- The affiant may add to the record relevant evidence that is missing from the affidavit thereby strengthening the opponent's case **OR** the affiant may be able to explain contradictions in her affidavit thereby strengthening the opponent's case. **(1 mark)**

f) Your client, upon being served with the opponent's evidence, would like to request an order for cross-examination and an extension of time to file the applicant's evidence. What are two (2) factors that the applicant should consider when making the request? **(2 marks)**

Answer:

- Making the request within two (2) months from the completion of all of the section 50 evidence **(1 mark)**;

- requesting an extension of time, asking that the extension begin to run from the completion of the cross-examination **(1 mark)**;
- if the applicant is in default of completing the cross-examination the four-month extension of time to submit and serve its section 52 evidence or statement will be automatically reduced to two months **(1 mark)**.

g) What will happen to the applicant's deadline for filing and serving its section 52 evidence if the applicant is in default of completing the cross-examination? **(1 mark)**

Answer:

- The four-month extension of time to submit and serve its section 52 evidence or statement will be automatically reduced to two months **(1 mark)**.

h) When asking questions in a cross-examination, what form should the questions ideally take? A. Open-ended questions. B. Closed-ended questions. **(1 mark)**
Explain why. **(1 mark)**

Answer:

- B. Closed-ended questions **(1 mark)** because open-ended questions provide the affiant with the opportunity of completing **OR** improving its evidence. **(1 mark)**

i) Identify five (5) relevant cross-examination questions that you, as the applicant's agent, could ask the affiant that would likely assist the applicant's case. Only the first five answers will be marked. **(5 marks)**

Answer:

Note to markers: Any question that finds its source in the facts asserted in the affidavit and that can reasonably lead to an answer (favourable or not) that is relevant to the legal issues raised in the opposition should receive a mark. Examples of such questions are provided below:

1. You were not working at your company during the time JAVEX was used between 2002 and 2018, correct? **(1 mark)**
2. In relation to paragraph 8 of your affidavit, you did not prepare the sales data of \$500,000 per year, correct? **(1 mark)**
3. In relation to paragraph 8 of your affidavit, provide the invoices supporting the alleged sales figures. **(1 mark)**
4. In relation to paragraph 8 of your affidavit, provide your company's financial statements for the years at issue. **(1 mark)**

5. You did not personally obtain the NUANS report referenced in paragraph 2, correct? **(1 mark)**
6. In paragraph 6 of your affidavit, the term Javex, does not stand out from the surrounding text - correct? **(1 mark)**

QUESTION 2 (15 MARKS)

Your client, HG Inc., is a Canadian gin manufacturer that owns registration No. TMA588,888 for the trademark HECTOR GIN in association with the goods “alcoholic beverages, namely gin”. Your client’s mark issued to registration on January 11, 2012 and your client has used the mark in Canada since at least as early as June 4, 2009.

Your client has expressed interest in opposing the following application, which was advertised in the *Trademarks Journal* on June 10, 2019:

Trademark: HEKTOR

Applicant: Maxwell Smith

For use in association with the goods “non-alcoholic beverages, namely tonic water”

The application claims proposed use in Canada.

Before the initial expiration of the advertisement period on August 10, 2019, your client instructed you to request a six-month extension of time to oppose the application, amounting to a cooling-off period, to allow for the possibility of resolving the matter by way of settlement. During settlement discussions, it was disclosed that Maxwell Smith is not the owner of the applicant business nor is he involved in the business, he simply filed the application on behalf of his brother, David Smith, who is the president of the applicant’s business. Thereafter, settlement negotiations were only held between your client and David Smith.

Your client currently faces a deadline of February 10, 2020 to file a statement of opposition. On February 2, 2020, following unsuccessful settlement negotiations, your client instructed you to proceed with the preparation and filing of a statement of opposition.

- a) Based on the information available and excluding any issues relating to the confidentiality of any disclosures, identify the four (4) strongest grounds of opposition by citing the relevant provisions of the *Trademarks Act* **(8 marks – 1 mark for each of the relevant provisions)**. For each ground alleged, state the necessary fact(s) justifying your selection. **(4 marks - 1 mark per ground) (total: 12 marks)**

Answer:

Paragraph 38(2)(a) **(1 mark)** and subsection 30(e) **(1 mark)**.

The listed applicant, Maxwell Smith, could not make the statement that he intends to use the mark in Canada because he filed the application for his brother **OR** his brother is the true owner of the trademark. (1 mark)

Paragraphs 38(2)(b) (1 mark) and 12(1)(d) (1 mark).

Confusing with registration No. TMA588,888 for the trademark HECTOR GIN (1 mark).

Paragraphs 38(2)(c) (1 mark) and 16(3)(a) (1 mark).

Confusing with the Opponent's trademark HECTOR GIN that it previously used in Canada in association with gin (1 mark).

Paragraph 38(2)(d) (1 mark) and section 2 (1 mark).

The applied for mark is not distinctive because it is confusing with the Opponent's trademark HECTOR GIN which had been previously used in Canada in association with gin (1 mark).

- b) You proceed to file your client's statement of opposition and the Registrar subsequently forwards the statement of opposition to the applicant on February 10, 2020. On April 3, 2020, the applicant files and serves its counterstatement, which is accompanied by a request for an interlocutory ruling (IR) to strike portions of the statement of opposition. Will the Registrar request your comments on this IR? Yes or No. (1 mark) Provide a brief explanation for your answer (1 mark) and cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

- No (1 mark) the Registrar will not request your comments on the IR.
- the Registrar will not even consider the request for the IR because such request must be made prior to the filing and serving of the counterstatement. (1 mark)
- subsection 38(6) of the *Trademarks Act*. (1 mark)

QUESTION 3 (3 MARKS)

The following questions relate to opposition proceedings.

- a) True or False. An opponent, when alleging a ground of opposition under paragraph 12(1)(d) of the *Trademarks Act*, may rely on a registered trademark standing in the name of a third party. (1 mark)

Answer: True. (1 mark)

- b) True or False. In accordance with the provisions of the *Trademarks Act*, RSC 1985 c T-13 as amended June 17, 2019, in an appeal to the Federal Court of a decision by the Registrar, new evidence may be brought as of right. (1 mark)

Answer: False. (1 mark)

- c) True or False. In accordance with the provisions of the *Trademarks Act*, RSC 1985 c T-13 as amended June 17, 2019, a statement of opposition must be filed in duplicate. (1 mark)

Answer: False. (1 mark)

QUESTION 4 (2 MARKS)

Your client wishes to oppose an application, which was advertised on September 15, 2019. Based on the information available, an allegation of 'bad faith' by the applicant will be the key ground of opposition. What ground of opposition will need to be pleaded? (1 mark). Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

- That the application was filed in bad faith. (1 mark)
- Paragraph 38(2)(a.1) of the *Trademarks Act*. (1 mark)

QUESTION 5 (14 MARKS)

The following true or false questions relate to section 45 proceedings. For each true or false answer, support your answer with the most specific applicable authority (section of the *Trademarks Act* or *Trademarks Regulations* or Practice Notice) where applicable. If there is no authority, state so.

- a) The requesting party has four months within which to file its evidence after the registered owner has filed its evidence in response to a section 45 notice.

Answer:

- False. (1 mark)
- Subsection 45(1) of the *Trademarks Act*. (1 mark)

- b) Any person who pays the prescribed fee may file a written request asking the Registrar to forward a section 45 notice to the registered owner of a trademark that has been registered for a period of three or more years.

Answer:

- True. (1 mark)
- Subsection 45(1) of the *Trademarks Act*. (1 mark)

- c) Service of evidence in section 45 proceedings may be effected by personal service, registered mail, fax, or email.

Answer:

- True. (1 mark)

- Section 71 of the *Trademarks Regulations*. (1 mark)

- d) The requesting party must copy the registered owner of a trademark on its request asking the Registrar to initiate section 45 proceedings.

Answer:

- False. (1 mark)
- There is no obligation to do so (in the *Trademarks Act*, in the *Trademarks Regulations* or in any Practice Notice) **OR** there is no authority requiring this. (1 mark)

- e) The party that requested that the Registrar send a section 45 notice (the requesting party) pays all costs associated with cross-examination of an affiant during the proceeding.

Answer:

- False. (1 mark)
- There is no authority in the *Trademarks Act* or *Trademarks Regulations* permitting cross-examination in section 45 proceedings. (1 mark)

- f) If the Registrar receives a written request to initiate section 45 proceedings against a registration that is already the subject of a section 45 proceeding for which a decision has issued and is currently under appeal, the Registrar may decide not to issue a section 45 notice.

Answer:

- True. (1 mark)
- Practice Notice dated June 17, 2019, "Practice in section 45 proceedings", II.1.4 – Good reasons not to issue the Notice. (1 mark) **[Note: Date, title or section number/heading of the Practice Notice is not required to receive the mark.]**

- g) The Registrar has discretion to issue a section 45 Notice prior to the mark having been registered for three years.

Answer:

- False. (1 mark)
- Practice Notice dated June 17, 2019, "Practice in section 45 proceedings", II.1.5 – No authority to issue the notice. (1 mark) **[Note: Date, title or section number/heading of the Practice Notice is not required to receive the mark.]**

QUESTION 6 (10 marks)

On behalf of your client, you requested the issuance of a section 45 notice against registration No. TMA135,246 for the trademark GOAT in association with the goods “watches, ankle bracelets, sunglasses, t-shirts”, and the services “restaurant services”.

In response to this notice, which was issued by the Registrar on July 5, 2019, the owner of the registration, ABC Inc., filed the following affidavit:

TO: The Registrar of Trademarks

IN THE MATTER OF a Section 45 Proceeding
regarding Canadian Registration No.
TMA135,246 for the trademark GOAT in the
name of ABC Inc.

AFFIDAVIT OF JOHN JONES

I, John Jones, of the City of Ottawa, in the Province of Ontario, in Canada, hereby
MAKE OATH AND SAY:

1. I am the President of ABC Inc. (the “Registrant”), an Ontario corporation whose principal place of business is located at 23 Acorn Street, Ottawa, Ontario, Canada.
2. I have held this position since 2009.
3. I am authorized to make this affidavit, and all statements I make herein are either from my personal knowledge or derived from the records of the Registrant which are maintained in the ordinary course of business.
4. During the period from July 5, 2016 to July 5, 2019 (the “Relevant Period”), ABC Inc. sold watches bearing the trademark GOAT to retailers in Canada. Attached as Exhibit A to my affidavit is a photograph of a watch that is representative of the watches that ABC Inc. sold during this period [*Exhibit A shows a watch with the word GOAT printed on the middle of the watch face*]. ABC Inc. also sold ankle bracelets. Attached as Exhibit B to my affidavit is a photograph that is representative of ABC Inc.’s current line of ankle bracelets [*Exhibit B shows an ankle bracelet with the word GOAT etched on the clasp of the bracelet*].
5. ABC Inc. has sold its watches and jewellery, including the watches shown in Exhibit A, and various ankle bracelets, to local Ottawa-area jewellery stores. Attached as Exhibit C is a spreadsheet displaying sales transactions to these jewellery stores during the Relevant Period [*Exhibit B shows over 300 sales transactions and details including the dates of sale, names of the Ottawa-area retailers that purchased the watches and ankle bracelets, invoice numbers for the watches, and pricing. All transactions are dated during the Relevant Period*].

6. Since 2014, ABC Inc. has been advertising its sunglasses in various newspapers, including the local Ottawa area newspaper. Attached as Exhibit D is a representative sample of these advertisements [*Exhibit D shows a newspaper advertisement that reads “GOAT sunglasses – get on over and pick up a pair!”*].
7. ABC Inc. has had sales in excess of \$100,000 CAD of its GOAT t-shirts to Canadian retailers during the Relevant Period. Attached as Exhibit E to my affidavit is a photograph of a t-shirt that is representative of the type of shirt sold during the Relevant Period [*Exhibit E shows a t-shirt bearing a label with the word GOATEE as one word and in capital letters in the same size and font. No other markings appear on the shirt*].
8. ABC Inc. also operates a number of GOAT vegetarian restaurants in the Ottawa area. Attached as Exhibit F to my affidavit are representative photographs of the restaurant signage and restaurant uniforms worn by the waiting staff during the Relevant Period. [*Exhibit F consists of 1) a photograph of restaurant signage displaying a drawing of a goat, and 2) a photograph of a restaurant uniform with the word GOAT printed clearly on the front and back of the uniform*].

John Jones

SWORN BEFORE ME in the City of Ottawa, in the Province of Ontario, this 5th day of September 2019.

Jane Jensen

Commissioner for Taking Affidavits for the Province of Ontario
My commission does not expire.

In accordance with the questions below, for each of the goods and services listed in the registration, provide your client with an opinion on whether the registration will be maintained or expunged for those goods and services and briefly explain why. Base your opinion solely on the evidence provided, and the relevant principles of law. There is no requirement to cite case law unless specifically requested.

- a) For the goods “watches”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).

Answer:

- Maintained. (**1 mark**)
- There is evidence of sales during, and a specimen from, the Relevant Period. (**1 mark**)

- b) For the goods “ankle bracelets”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).

Answer:

- Expunged. (**1 mark**)
- There is no specimen showing how the mark appeared on ankle bracelets during the Relevant Period. (**1 mark**)

- c) For the goods “sunglasses”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).

Answer:

- Expunged. (**1 mark**)
- There is only advertising for sunglasses, which does not constitute trademark use with goods. (**1 mark**)

- d) For the goods “t-shirts”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).

Answer:

- Expunged. (**1 mark**)
- GOATEE does not qualify as use of GOAT when applying deviation test **OR** dominant impression created by the marks is not the same. (**1 mark**)

- e) For the services “restaurant services”, advise whether the registration will be maintained or expunged (**1 mark**). Give one valid reason to support your opinion (**1 mark**).

Answer:

- Maintained. (**1 mark**)
- The mark appears on uniforms worn by employees in the performance of restaurant services. (**1 mark**)

QUESTION 7 (8 marks)

Your client, Rainbow Bikes Inc., has been using the trademark RAINBOW BIKES since January 2004 in association with its business involving the sale and servicing of bicycles. It has never obtained a trademark registration for RAINBOW BIKES and operates one bike shop in Gatineau, Quebec.

Your client recently received a demand letter from Cycling Strong Inc, which owns a Canadian registration for the trademark COLOURS OF THE RAINBOW. The COLOURS OF THE RAINBOW registration issued on April 15, 2017, based on alleged use of the mark in Canada since 2007, in association with: “travel services, namely, organising and leading bicycle trips”. Cycling Strong Inc. also owns a registration for RAINBOWS AND MORE. That registration issued on May 12, 2012 for: “clothing, namely, athletic shorts and tops; water bottles; messenger bags and backpacks”.

Cycling Strong Inc. is asking that Rainbow Bikes Inc. stop using the trademark and trade name RAINBOW BIKES in Canada. Your client is asking you for advice as to how to respond to this letter.

- a) After receiving the demand letter, Rainbow Bikes had an investigator see what it could find regarding the operations of Cycling Strong Inc. The investigator could not find any information regarding possible dates for future tours offered by Cycling Strong and all that the investigator could find, online, were photos of tours that took place in 2008 and 2009. It seems, however, that RAINBOWS AND MORE bags, tops and shorts are available for sale online at this time. On the basis of the above, what would you tell your client regarding the possible cancellation of the COLOURS OF THE RAINBOW registration and the RAINBOWS AND MORE registration, pursuant to section 45, including whether or not it would be possible to cancel each registration **(2 marks)** and the reasons why or why not. **(2 marks)**

Answer:

- It would likely not be possible to cancel the registration for RAINBOWS AND MORE **(1 mark)** because the mark appears to be still in use with the goods that are covered by that registration **(1 mark)**.
- It would not be possible to cancel the registration for COLOURS OF THE RAINBOW at the present time **OR** it would likely be possible if we waited until April 15, 2020 to request the issuance of the section 45 notice **(1 mark)** because that registration issued less than three years ago and is therefore not vulnerable to cancellation **(1 mark)**.

- b) The investigator purchased one of the RAINBOWS AND MORE shirts. The label on the shirt shows the following: Wear it Proud Inc. Your client suspects that the mark might be used by an entity other than the owner of the registration. How might this affect your client's position and why **(2 marks)**?

Answer:

- It might be possible to cancel the registration for RAINBOWS AND MORE (**1 mark**) if the owner, Cycling Strong Inc., cannot show that it had licensed We Are Proud Inc. to use the mark in Canada (**1 mark**).

- c) The investigator has found that the COLOURS OF THE RAINBOW tours that were offered in 2008 and 2009 took place in Vancouver and in Saskatoon. Rainbow Bikes insists that it simply wants to continue using its mark and name in Gatineau. Can Cycling Strong Inc. rely on its registration to prevent the use of the mark RAINBOW BIKES in Ottawa? Yes or No (**1 mark**), and briefly explain your answer (**1 mark**) and cite the relevant provisions of the *Trademarks Act* in support of your answer (**2 marks**).

Answer:

- Yes. (**1 mark**)
- The owner of a federal registration has the right to enforce its rights across the country. (**1 mark**)
- Sections 19 and 20 of the *Trademarks Act*. (**2 marks**)

QUESTION 8 (10 marks)

Your client Flying High Inc. owns a registration for the trademark FLYING HIGH covering “confectionery, namely, gum drops”. The client filed its Declaration of Use on April 30, 2019 and the registration issued on May 15, 2019. Your client has received a Section 37(3) Notice from the Trademarks Office regarding an application for the trademark FLYING HIGH AS A KITE covering “non-alcoholic beverages, namely, fruit juices and spritzers”. That application is owned by Pie in the Sky Inc. The application is based on alleged use of the mark in Canada since at least as early as January 1, 2012 and was published for opposition on November 1, 2019.

- a) On a first review of these facts, would you recommend that your client consider opposing this application – yes or no? (**1 mark**) What fact is motivating your answer (**1 mark**) and provide the relevant statutory provision(s). (**2 marks**)

Answer:

- No (**1 mark**).
- Because the Applicant claims use of its mark in Canada prior to the date of first use of my client’s mark and could seek to invalidate my client’s registration. (**1 mark**)
- Subsections 17(2) and 57(1) of the *Trademarks Act*. (**2 marks**)

- b) It is difficult for you to obtain instructions from your client. What is the deadline by which you must oppose the application (**1 mark**) and can that deadline be extended (**1 mark**) and, if so, for how long (**1 mark**)?

Answer:

- The deadline to oppose is January 1, 2020 **OR** effectively January 2, 2020 (**1 mark**).
- That deadline can be extended (**1 mark**) for 4 months (**1 mark**).

- c) When opening a file for this matter, you realise that your firm has in the past represented Pie in the Sky Inc. in employment matters. List three things that you would do once you have that information in hand, along with the section 37(3) Notice (**3 marks**).

Answer:

- (1) Enter the opposition deadline (**1 mark**);
- (2) Confirm that your firm no longer represents Pie in the Sky Inc. in any matters (**1 mark**);
- (3) Report receipt of the Section 37(3) Notice to Flying High Inc. (**1 mark**)

QUESTION 9 (2 MARKS)

Your client Bell Flowers Inc. owns a registration for HIGH FIVE covering “breads and rolls”. It would like to register the same mark for use in association with “granola, granola bars and cookies”. Your client’s registration issued over six months ago. Can the original registration be extended to cover those goods – yes or no? (**1 mark**) Cite the relevant section of the *Trademarks Act*. (**1 mark**)

Answer:

- Yes (**1 mark**).
- Subsection 41(2) of the *Trademarks Act*. (**1 mark**)

QUESTION 10 (4 MARKS)

- a) The *Combating Counterfeit Products Act* amended six federal statutes. List three of them. (**3 marks**) Only the first three answers listed will be marked.

Answer:

- *Copyright Act*, *Trademarks Act*, *Access to Information Act*, *Criminal Code*, *Customs Act*, *Olympic and Paralympic Marks Act*. (**1 mark each up to 3 marks**)

- b) The *Combating Counterfeit Products Act* generally prohibits the import and export of counterfeit goods. Identify one exception to this prohibition. (1 mark) Only the first answer will be marked.

Answer:

- (1) Goods imported or exported by an individual (in their possession or baggage) where the circumstances indicate that the goods are intended only for their personal use; (1 mark) **OR**
- (2) Goods that are transitioning through Canada from one place outside Canada to another place outside Canada; (1 mark) **OR**
- (3) The mark was applied for with the consent of the owner of the mark in the country where the mark was applied for. (1 mark).

QUESTION 11 (40 marks)

Your ultimate client, Radar Security S.A., is a Swiss company that specialises in security systems (motion detectors, cameras, door & window sensors, etc.), mostly for homes and small businesses, all sold under the trademark RADAR. However, you do not deal directly with Radar Security S.A., but rather with its Canadian subsidiary Radar Security Inc., that has a small office in Canada and a few sales agents in several major Canadian cities. Radar Security Inc. has a promotional website at www.radarsecurity.ca, which promotes all of Radar Security S.A.'s above-mentioned products and has been doing so since 2005. You may assume that there is a formal and valid licence authorising Radar Security Inc. to use the trademark RADAR in Canada.

Radar Security S.A. has recently developed a new service, under the trademark RADAR, which is a cloud based application that runs on Radar Security S.A.'s servers in Switzerland and is aimed at integrating a vast security system deployment in commercial (e.g. shopping malls) and industrial (e.g. factories) settings. This service, commonly known as Software as a Service "SaaS", was formally launched in September 2017 and has been promoted by Radar Security Inc. since the product launch, notably on its website and through brochures distributed to prospective clients. This new product was an immediate success in Europe and has been sold extensively in Europe since the launch. However, this SaaS has not yet been sold in Canada, notwithstanding serious efforts to commercialise it by having sales agents visit several potential clients, showing them how it works and what it is capable of achieving.

Radar Security S.A. is the owner of Canadian trademark application 2,233,445 for the trademark RADAR in association with the goods "*software for integrating and managing an array of security devices; monitors*". The application was filed in Canada on January

15, 2018 on the basis of registration and use in Switzerland and claims priority to an application filed in Switzerland on July 20, 2017 under number 987765. Application 2,233,445 is still pending, as you are trying to overcome an objection raised by the examiner on the basis of Canadian trademark registration TMA987,123 for the trademark SONAR in association with the goods “security systems”, which issued to U.S. company Stars ‘n’ Stripes Protection Ltd. on November 23, 2016.

Stars ‘n’ Stripes Protection Ltd. sells the same type of products as Radar Security S.A. but its clientele is exclusively comprised of military, paramilitary and police forces, which is not a business sector of interest to Radar Security S.A. As there is no competition whatsoever between Radar Security S.A. and Stars ‘n’ Stripes Protection Ltd., and since there have been other instances of conflict between the marks RADAR and SONAR in other jurisdictions, Radar Security S.A. has taken the initiative of contacting Stars ‘n’ Stripes Protection Ltd. for the purposes of concluding a worldwide coexistence agreement. Discussions have been ongoing for over a year with not much progress and not much, if any, involvement on your behalf.

Radar Security S.A. does not own any other trademark applications or registrations in Canada.

In February 2019, you received the following e-mail from your client:

The guys in Switzerland just informed me that an application by Stars ‘n’ Stripes Protection Ltd. was just published (whatever that means) and sent me the following information (which I hope you’ll understand as it doesn’t mean much to me):

*Trademark: SONAR
Country: Canada
Applicant: Stars ‘n’ Stripes Protection Ltd.
Goods/services: software
Filing date: 2017-12-01
Filing basis: proposed use
Application No. 2,123,456
Status: Published 2019-02-06
Agent: Smith Tremblay Goldberg LLP, Toronto*

The guys want to know if there is anything you can do about this, you know, to get better leverage for their discussions with S’n’S. But they don’t want to put too much into this, so try to keep it at a minimum.

I don’t know if this is relevant, but I have never heard of S’n’S going into or offering any type of software. (I even asked one of my buddies who works

there – should keep that to yourself, I don't want to get him into trouble – about this and he was surprised I even suggested that).

- a) In these circumstances, on what basis can it be argued that there is confusion between the trademarks RADAR and SONAR? Provide the two main factors to be considered. **(2 marks)**

Answer:

- The goods and services are of the same nature **(1 mark)** and there is a degree of resemblance between the trademarks in the ideas suggested by them **(1 mark)**.

- b) In view of your general instructions, you consider whether to file an opposition or request an extension of time to do so. What are the official fees for each? **(2 marks)** Cite the authority. **(1 mark)**

Answer:

- \$750 to file a statement of opposition; **(1 mark)**
- \$125 to request an extension of time; **(1 mark)**
- Schedule 1 of the *Trademarks Regulations*. **(1 mark)**

- c) In light of the ongoing discussions between the parties, you recommended that your client request a nine-month extension of time, amounting to a cooling-off period. You requested said extension, which was granted by the Registrar. What was required in order for the Registrar to grant the extension of time? **(2 marks)** Cite the authority supporting your answer. **(1 mark)**

Answer:

- Consent from the applicant **(1 mark)**, and payment of the prescribed fee **OR** payment of \$125. **(1 mark)**
- Practice Notice dated June 17, 2019, "*Practice in trademark opposition proceedings*" **(1 mark)**. **[Note: Date and title of Practice Notice not required to receive the mark.]**

- d) The opposition deadline is in two weeks and the discussions between the parties have not been successful. You have therefore been instructed to proceed with the opposition. Which grounds of opposition can be considered: the pre-June 17, 2019 provisions of the *Trademarks Act* or the provisions in force since June 17, 2019? **(1 mark)** Cite the relevant provision of the *Trademarks Act* justifying your answer. **(1 mark)**

Answer:

- The provisions of the *Trademarks Act* as they read before June 17, 2019. **(1 mark)**
- Section 70 of the *Trademarks Act*. **(1 mark)**

- e) Who is entitled to oppose the application, Radar Security S.A., Radar Security Inc. or both parties? **(1 mark)**

Answer:

- Both. **(1 mark)** *[Note: No mark will be given for identifying only one of the two.]*

- f) Draft five (5) grounds of opposition that can reasonably be raised on the basis of the facts provided above. **(23 marks, i.e. 4 marks per ground – 6 marks for a particular ground that requires a more developed answer – for substance, reference to the appropriate provisions of the *Trademarks Act* and 1 mark for overall clarity and conciseness)** Only the first five grounds will be marked. No marks will be given for a ground of opposition based on suppositions or hopes that something may turn up in the evidence stage.

Answer:

[Note to markers: If the candidate applied the wrong version of the *Trademarks Act*, he/she may get marks for the substantive portions of the grounds of opposition and for being clear/concise, but not for references to sections of the *Trademarks Act*.]

- Pursuant to paragraph 38(2)(a) of the *Trademarks Act* (hereinafter the “Act”) **(1 mark)**, the Application does not comply with the requirements of paragraph 30(a) of the Act **(1 mark)** in that the goods listed in the application **(1 mark, no mark if the candidate states “services”)** are not stated in ordinary commercial terms **OR** are too broad. **(1 mark)**

- Pursuant to paragraph 38(2)(a) of the Act **(1 mark)**, the Application does not comply with the requirements of paragraph 30(e) of the Act **(1 mark)** in that the Applicant did not intend to use the applied for trademark **OR** the trademark SONAR in Canada **(1 mark)** in association with the goods “software” **OR** the goods listed in the Application. **(1 mark)**

- Pursuant to paragraph 38(2)(c) of the Act **(1 mark)**, the Applicant is not the person entitled to registration of the applied for mark having regard to paragraph 16(3)(b) of the Act **(1 mark)** in that, at the date of filing of the application, it was confusing with the trademark RADAR **(1 mark)**, which is the subject of trademark application 2,233,445 **(1 mark)** for the goods “software for integrating and managing an array of security devices; monitors” **(1 mark)** and which is deemed to have been filed on July 20, 2017. **(1 mark)**

- Pursuant to paragraph 38(2)(c) of the Act **(1 mark)**, the Applicant is not the person entitled to registration of the applied for mark **OR** the trademark SONAR having regard to paragraph 16(3)(a) of the Act **(1 mark)** in that, at the date of filing of the Application, it was confusing with the trademark RADAR **(1 mark)**, which has been used in Canada by the Co-Opponent Radar Security S.A. (under licence by Radar Security Inc. – reference

to the licensee not required to get the mark) since September 2017 in association with the services “software as a services for integrating and managing an array of security devices” and which is still used by the Co-Opponent Radar Security S.A. and has not been abandoned. **(1 mark)**

- Pursuant to paragraph 38(2)(c) of the Act **(1 mark)**, the Applicant is not the person entitled to registration of the applied for mark **OR** the trademark SONAR having regard to paragraph 16(3)(c) of the Act **(1 mark)** in that, at the date of filing of the Application, it was confusing with the trade-name RADAR SECURITY INC. **(1 mark)**, which has been used in Canada by the Co-Opponent Radar Security Inc. since September 2017 in association with the services “software as a services for integrating and managing an array of security devices” and which is still used by the Co-Opponent Radar Security inc. and has not been abandoned. **(1 mark)**

(+1 mark for clear and concise style)

[Note to markers: For the 4th and 5th grounds above it is important to refer to the services “software as a service for...”, which is consistent with the fact scenario and which is what can be claimed as used in Canada under subsection 4(2) of the Act, and the goods described in the application, which is only relevant to the 3rd ground above.]

g) How can the statement of opposition be served on Stars ‘n’ Stripes Protection Ltd.? **(1 mark)** Cite the relevant provision of the *Trademarks Act*. **(1 mark)**

Answer:

- The statement of opposition is not to be served on Stars ‘n’ Stripes Protection Ltd. or its agent, it is filed with the Registrar. **(1 mark)**
- Subsection 38(1) of the *Trademarks Act*. **(1 mark)**

h) What’s the best strategy could you recommend to overcome the objection raised on the basis of Stars ‘n’ Stripes Ltd.’s registration TMA987,123? **(2 marks)** Cite the authority for such a recommendation. **(2 marks)**

Answer:

- Initiate legal action before [**OR** file an application with] the Federal Court to invalidate the registration **(1 mark)** pursuant to section 57 of the *Trademarks Act* **OR** section 20 of the *Federal Courts Act* **(1 mark)** on the basis that the trademark SONAR **OR** the trademark that is the subject of the registration is confusing with the trademark RADAR previously used in Canada in association with security systems **(1 mark)** contrary to paragraph 18(1)(d) of the *Trademarks Act* **(1 mark)**.

QUESTION 12 (3 marks)

Your client is in the business of well-aged wine and spirits. The client wants to launch a new wine under the trademark IL VINO DELL'AMORE and asked you to proceed with a trademark clearance search. The search revealed the following:

Trademark: IL VINO DELL'AMORE
Owner: Les vins Réginald Fafard & Fils Ltée
Goods/services: wine
Registration number: TMA246,357
Registration date: 1974-04-14
Agent: Smith Tremblay Goldberg LLP, Toronto

You reported to your client that this trademark registration posed an obstacle to registration of their proposed, subject to possible Section 45 proceedings to have the registration expunged for non-use (you never heard of that brand of wine and conducted a quick Internet search and found no recent reference to it). You therefore suggested to your client that it investigate a little further.

A week later, your client wrote back to you informing you that the only province in Canada where Les vins Réginald Fafard & Fils Ltée ever sold its wine IL VINO DELL'AMORE was in Québec. Your client also informs you that the wine in question was discontinued over three years ago and provides you with publicly available information from the Société des Alcools du Québec (or SAQ, the provincial liquor board) showing without a doubt that the last shipment of IL VINO DELL'AMORE wine was for 175 cases (of 12 bottles) sold and delivered on October 25, 2016.

In this context, do you recommend that your client immediately initiate summary cancellation proceedings pursuant to Section 45 of the *Trademarks Act*? Yes or no. **(1 mark)** Provide the elements supporting your recommendation. **(2 marks)**

Answer:

- No. **(1 mark)**

- The SAQ is not the last step in the "normal course of trade". **(1 mark)** It is likely that consumers bought IL VINO DELL'AMORE wine less than three years ago. **(1 mark)**

QUESTION 13 (10 marks)

Match the case name with the most applicable legal principle. You have been provided with more legal principles than cases. Only one principle should be paired with one case. If you provide multiple principles for a case, only the first legal principle will be marked.

Case Name	Principle
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A. <i>Nissan Canada Inc v BMW Canada Inc</i> , 2007 FCA 255 (the "M" mark case)	1. It is undoubtedly a famous trade-mark that deserves wide protection not only from free-riders but from those who, without any intention of free-riding, nevertheless use in their own business distinguishing marks that create confusion or depreciate the value of the goodwill attaching to those of the appellant.
B. <i>Bojangles' International LLC v Bojangles Café Ltd</i> , 2006 FC 657	2. If a mark was used differently than registered, the issue is, was the mark used in such a way that the mark did not lose its identity and remained recognizable in spite of the difference between the form in which it was registered and the form in which it was used.
C. <i>Promafil Canada Ltd v Munsingwear Inc</i> (1992), 44 CPR (3d) 59 (FCA)	3. A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient.
D. <i>Scott Paper Limited v Smart & Biggar</i> , 2008 FCA 129	4. If the wares or services originate in the place referred to by the trade-mark, then the trade-mark is clearly descriptive of place of origin.
E. <i>Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée</i> , 2006 SCC 23	5. The general rule is that absence of use is penalized by expungement.
F. <i>Masterpiece Inc v Alavida Lifestyles Inc</i> , 2011 SCC 27	6. It is worth bearing in mind that the number of items in the Trade Mark description are relatively few, so that it would not have required a great deal of trouble to "show" examples for each of them. This would not be requiring evidentiary overkill.
G. <i>MC Imports Inc v AFOD Ltd</i> , 2016 FCA 60 (the LINGAYEN mark case)	7. What subsection 45 requires is an affidavit or statutory declaration not merely stating but "showing", that is to say, describing the use being made of the trade mark within the meaning of the definition of "trade mark" in section 2 and of "use" in section 4 of the Act. The subsection makes this plain by requiring the declaration to show with respect to each of the wares and services specified

	in the registration whether the trade mark is in use in Canada and if not the date when it was last used and the reason for the absence of such use since that date.
H. <i>Uvex Toko Canada Ltd v Performance Apparel Corp</i> , 2004 FC 448 (the HOT CHILLY'S mark case)	8. A variant of the registered mark will constitute use of the registered mark providing the variant is not substantially different from the registered design.
I. <i>Canada (Registrar of Trade-marks) v Cie Internationale pour l'informatique CII Honeywell Bull, SA</i> (1985), 4 CPR (3d) 523 (FCA)	9. Statutory passing off under section 7(b) does not require a party to demonstrate that there is a trademark within the meaning of section 2 of the Trademarks Act.
J. <i>Plough (Canada) Ltd v Aerosol Fillers Inc</i> (1980), 53 CPR (2d) 62 (FCA)	10. For the use of a mark in advertisement and promotional material to be sufficiently associated with a ware to constitute use, the advertisements and promotion material would have to be given at the time of transfer of the property in or possession of the wares.
	11. The location where a mark is used is irrelevant when considering the likelihood of confusion between an applied for or registered trade-mark and a prior unregistered trade-mark or trade-name.
	12. The nature of wares or services should have less weight in a confusion analysis because the famous mark more likely will lead to the inference that the source of the two is the same.

Answer:

A-10; B-3; C-8; D-5; E-1; F-11; G-4; H-6; I-2; J-7.

QUESTION 14 (3 MARKS)

You represent a client who has an ongoing “feud” with one of its competitors. Your client has asked that you file applications for marks that are similar to the marks of this competitor, even if your client has no intention of ever using those marks, but only in order for its competitor to spend time and money opposing those applications and guarding against your client. This situation has been going on for a while and you consider this behaviour to be incongruous with your duties as a trademark agent.

- a) Can you unilaterally withdraw your services from this client? (1 mark) Explain why. (1 mark)

Answer:

- Yes. (1 mark)
- A trademark agent must withdraw when a client persists in instructing the agent to act contrary to professional ethics or contrary to the law. (1 mark)

- b) Regardless of your previous answer, what would you need to do in order to withdraw your services? (1 mark)

Answer:

- You must provide your client with notice that is reasonable under the circumstances. (1 mark)

QUESTION 15 (6 MARKS)

Your client, ABC Inc., a federally incorporated corporation ("ABC"), is an up and coming handbag manufacturer established in May 2016 and based in Toronto, Ontario. ABC prominently displays its trademark SMOKY ALLEGRETTO on all of its handbags. These handbags are currently offered for sale and sold through ABC's retail stores in Vancouver, Calgary, Toronto, Montreal, and Halifax. ABC also sells its SMOKY ALLEGRETTO handbags to consumers across Canada through its company website.

ABC recently attended a Western Canada Fashion Accessories Exhibition in Calgary, Alberta. At the Exhibition, ABC learned that a new handbag manufacturer, 123789 Ltd., just set up a pop-up store in Calgary offering for sale and selling women's purses in association with the near identical trademark SMOKY ALLEGRETTOS. Apparently, this pop-up store has been very successful and 123789 Ltd. is planning to open more pop-up stores in Calgary and Vancouver within the next six months. Your client is very concerned and has come to you for advice.

Given that your client does not own a registration for its trademark SMOKY ALLEGRETTO, you advise your client that it is not eligible to bring an action for trademark infringement under section 20 of the *Trademarks Act*. However, you explain that it is possible to bring an action for passing off against 123789 Ltd. Please provide brief answers to the following questions.

- a) In what jurisdiction(s) [and specifically, in which courts] can the client validly bring a passing-off action? (3 marks)

Answer:

The passing off action can be commenced in Alberta provincial court (1 mark), BC provincial Court (1 mark), and/or in the Federal court (1 mark).

b) List the necessary elements of a passing-off action involving a trademark. (3 marks)

Answer:

- Goodwill or reputation in the trademark; (1 mark)
- Deception of the public due to misrepresentation by the Defendant; (1 mark) and
- Actual or potential damage to the plaintiff. (1 mark)

QUESTION 16 (3 MARKS)

Your client instructs you on November 25, 2019 to urgently renew registration No. TMA987,123 that expires on the same day. The registration covers “cosmetics, t-shirts and mugs” and the goods are not currently grouped according to the Nice Classification. Your client only wants to renew the registration for “cosmetics” and you therefore proceed with the online renewal and pay the renewal fee for one Class (\$400).

Describe how the Trademarks Office will process the renewal. (3 marks)

Answer:

- Since the fee for the first class was paid, the registration will be renewed. (1 mark)
- However, since the goods were not grouped according to the Nice Classification, partial renewal could not be submitted online. The Registrar will therefore issue a notice requesting the classification of the goods (1 mark) and payment of the statutory fees for the missing classes (1 mark).